Supreme Court, U.S.
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No. ——

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

UNITED STATES SURGICAL CORPORATION,
Petitioner,

v.

ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether patent claim construction for use in infringement and obviousness analysis is a matter exclusively for the court, as the Court of Appeals for the Federal Circuit recently held *en banc*, or for the jury, as the District Court and a panel of the Federal Circuit held in this case?

2. Whether the Court of Appeals for the Federal Circuit, when it summarily affirmed the judgment so as not to apply a soon-to-be-issued *en banc* ruling that would require a new trial in this case, so far departed from the usual and accepted course of judicial proceedings as to call for the exercise of this Court's power of supervision?

3. Whether the Court of Appeals for the Federal Circuit, when it condoned the jury's use of a non-evidential dictionary and refused to apply the presumption of prejudice arising from the jury's use of extraneous matter, was in direct conflict with controlling Second Circuit authority, as well as decisions of other federal (and state) courts?

4. Whether the Court of Appeals for the Federal Circuit, when it summarily affirmed the judgment in clear conflict with controlling Second Circuit authority requiring a new trial because of the jury's use of extraneous non-evidential matter, so far departed from the usual and accepted course of judicial proceedings as to call for the exercise of this Court's power of supervision?

LIST OF PARTIES

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of *Certiorari.*

LIST OF PARTIES PURSUANT TO RULE 29.1

Petitioner United States Surgical Corporation is a publicly held corporation with no parent companies. There are no subsidiaries or affiliates of United States Surgical Corporation that have issued shares to the public.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner United States Surgical Corporation ("U.S. Surgical") respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit ("CAFC") in the above-captioned case.

OPINIONS BELOW

The post-trial rulings of the District Court are unreported and are reproduced in the Appendix at App. 2a. The summary affirmance of the CAFC is unreported and is reproduced at App. 1a. The CAFC order denying rehearing is unreported and is reproduced at App. 32a.

JURISDICTION

The judgment of the CAFC was entered on February 14, 1995. App. 1a. U.S. Surgical filed a timely petition for rehearing and suggestion for rehearing *en banc*, which was denied on March 23, 1995. App. 32a. This Court has jurisdiction to review the judgment of the Court of Appeals pursuant to 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

U.S. Surgical obtained two patents, the '420 patent and the '057 patent, on the first endoscopic multiple clip applier, a medical instrument used primarily in endoscopic gallbladder operations. U.S. Surgical enjoyed immediate and great market success with its commercial embodiment, the ENDOCLIP.™ More than a year later, Ethicon, Inc. ("Ethicon"), a subsidiary of Johnson & Johnson, entered the market with its own endoscopic multiple clip applier, the EMCA, soon followed by the ERCA. U.S. Surgical brought suit in the United States District Court for the District of Connecticut contending that Ethicon's clip appliers infringed claim 1 of the '420 patent and claims 1, 2, and 7 of the '057 patent. Ethicon denied infringement and also contended these claims were "obvious" under 35 U.S.C. § 103.

Prior to the *en banc* decision of the CAFC in *Markman v. Westview Instruments, Inc.*, 34 USPQ2d 1321 (April 5, 1995), that court's precedents were in conflict concerning the respective roles of the court and jury in ascertaining the scope and meaning of patent claims in jury trials.[1] One line of CAFC precedents, culminating in *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H*, 945 F.2d 1546 (Fed. Cir. 1991), took the position that claim construction may have underlying factual

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[1] Chief Judge Archer, the author of the majority opinion in *Markman*, fully sets out the conflicting lines of CAFC precedent in Part III of his opinion, 34 USPQ2d at 1327-29.

inquiries that have to be submitted to a jury. The *Tol-O-Matic* line of cases encouraged trial courts not to give meaning-specific instructions but to submit unconstrued claims to a jury. Another, older line of CAFC precedents, culminating in *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992), took the position that construction of a patent claim was a matter of law exclusively for the court. Under *Read*, the jury receives meaning-specific instructions construing the claims, leaving no issue of construction for the jury. The jury then determines whether the accused device infringes the claims as defined for it.

The correct allocation of role between court and jury in claim construction is of immense importance not only in patent infringement analysis but also in "obviousness" analysis. The reason is that in an obviousness analysis the prior art must be compared to a properly construed claim; otherwise, the comparison of the prior art with the controverted claim will be clearly erroneous. *Smithkline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 885 (Fed. Cir. 1988); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Proponents of the *Read* line of cases maintain that having the court construe claims for the jury promotes predictability and consistency in both infringement and obviousness determinations, because a fully instructed jury will utilize the same claim construction (as given in the charge) in resolving both issues.

The CAFC recognized that it had divergent lines of cases and that the respective role of court and jury was of crucial importance in patent enforcement. For that reason, when the issue was presented in *Markman*, the CAFC, after oral argument on May 7, 1992 but before the panel's decision issued, took the highly unsual step, on November 5, 1993, of ordering *en banc* consideration. On January 7, 1994, the Court sought briefing on four questions that focused on the respective role of court and

jury in patent enforcement. App. 42a. The Court heard *en banc* argument on May 4, 1994.

U.S. Surgical filed suit for patent infringement on March 10, 1992, and at all times took the position that claim construction was a matter exclusively for the court, in accordance with the *Read* line of cases. Ethicon, the alleged infringer, sought refuge in the *Tol-O-Matic* line of cases. The special master, who initially ruled upon motions for summary judgment, sided with U.S. Surgical: "The jury's sole role is to determine whether the invention, as defined by the Court, has been made and sold by the defendants. *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992)." App. 41a. The special master recommended that the District Court, after consideration of expert evidence to aid it in its claim interpretation, "formulate appropriate instructions for the jury on the meaning of the claim . . ." *Id.* The Court (Eginton, J.) endorsed the recommendation of the special master.

But the case was then reassigned. The trial was in significant measure consumed by disputes over the scope and meaning of the claims at issue.[2] The new judge (Covello, J.), following *Tol-O-Matic*,[3] declined to define the meaning of the claims for the jury. App. 8a, App. 24a-26a. Instead, he opted for instructions that in the most general terms describe the approach the jury should take in construing a patent claim. He informed the jury

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[2] Each side presented its position through legal "experts" who offered conflicting views on the meaning of the patent claims, as well as on other legal issues, including the meaning of 35 U.S.C. § 103. As was clear under the *Read* line of cases, that testimony did not relieve the trial court of its obligation to construe the claims for the jury. This point is directly made in *Markman*, 34 USPQ2d at 1333.

[3] The trial court was acutely aware that the CAFC had two conflicting lines of cases, culminating in *Tol-O-Matic* and *Read*. App. 24a-26a.

that he had determined that there was a factual dispute concerning the meaning of the claims, and for that reason it was the jury's function to construe the claims and determine their meaning.[4] U.S. Surgical, which had submitted comprehensive, meaning-specific instructions construing the claims as required by *Read* (*see* App. 24a note 26), excepted to the Court's refusal to give meaning-specific jury instructions.

Left with a unconstrued claims, the jury, unguided and adrift, requested a dictionary on the first day of its deliberations. Over the objection of both parties, and without inquiry as to the need or intended use of the dictionary, the District Court answered the jury's request by providing it with Webster's *New World Dictionary*. *See* App. 30a-31a.

The jury returned a verdict that the accused EMCA and ERCA devices infringed claim 1 of the '420 patent but did not infringe claims 1, 2, and 7 of the '057 patent. The jury further found that all four claims were "obvious."

The District Court denied U.S. Surgical's post-trial motions. App. 2a. It relied upon *Tol-O-Matic* in defense of its position that it was not obliged to define the claims for the jury. App. 24a-26a. The Court admonished the parties not to talk to the jury, in accordance with its local Rule 12(f) prohibiting interviews of jurors. The Court ignored U.S. Surgical's request for a hearing to determine what use the jury made of the dictionary. *See* App. 30a-31a. It refused to apply the Second

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[4] To be accurate, there were any number of disputes, as the District Court correctly noted in its post-trial rulings. App. 24a. The Court did not define the parameters of any of the disputes for the jury. The parties had set forth their respective differences on claim charts that were the subject of extensive testimony. Under the *Read* line of cases, followed in *Markman*, these disputes do not create a factual issue for the jury, because it is the sole province of the court to interpret the claims and instruct the jury on their meaning.

Circuit's presumption of prejudice arising from the jury's use of the dictionary. To the contrary, it placed the burden on U.S. Surgical to demonstrate actual prejudice due to the dictionary. App. 31a. Of course, U.S. Surgical could not demonstrate actual prejudice after the Court refused to allow juror interviews and denied its request for a hearing.

On appeal to the CAFC, U.S. Surgical strenuously argued that it was entitled to a new trial because of the District Court's failure to construe the claims for the jury. Brief for Plaintiff-Appellant, pp. 34-35, 43-44, 49-50; Reply Brief for Plaintiff-Appellant, pp. 18-20. U.S. Surgical relied upon the *Read* line of cases; *Read* even was featured in its summary of argument. App. 45a. U.S. Surgical also argued that it clearly was entitled to a new trial because under controlling precedent of the Second Circuit, *United States v. Weiss*, 752 F.2d 777, 782-83 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985),[5] submission to the jury of non-evidential extraneous matter (the dictionary) was presumptively prejudicial, Ethicon had not rebutted the presumption of prejudice (which it had no means of doing in the absence of a hearing, in light of local Rule 12(f)), and therefore the CAFC had no legal alternative but to order a new trial. Brief for Plaintiff-Appellant, pp. 45-47, 50.

The case was argued before a panel of the CAFC on February 6, 1995. The panel consisted of Circuit Judges Newman and Rader, and Senior Circuit Judge Bennett. Judge Newman, who chaired the panel, was the author of the *Tol-O-Matic* opinion, and she had been joined in that opinion by Judge Rader (along with Senior Circuit Judge Skelton). On February 14, 1995, eight days after

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[5] The District Court's submission of the dictionary to the jury raises a trial issue not within the CAFC's unique jurisdiction. The controlling law is therefore that of the regional circuit in which the case was tried. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 855-58 (Fed. Cir. 1991), *cert. denied*, 112 S. Ct. 2957 (1992).

oral argument, the panel affirmed the judgment in this case without opinion. App. 1a. The panel invoked Federal Circuit Rule 36, which permits the entry of a judgment of affirmance without opinion in five limited circumstances, including affirmance of a judgment or decision "entered without error of law" and "an opinion would have no precedential value." App. 46a.

U.S. Surgical petitioned for rehearing and rehearing *en banc*. It argued to the panel that it was entitled to a reasoned explanation as to why submission of the dictionary to the jury did not mandate a new trial, in light of the contrary and controlling Second Circuit precedent, *United States v. Weiss*, *supra*. U.S. Surgical also pointed out that the CAFC's affirmance of the trial court's decision on the dictionary point was a departure from all available precedent regarding the jury's use of a non-evidential dictionary. In addition to the dictionary issue, U.S. Surgical argued to the CAFC as a whole that it should defer further consideration of U.S. Surgical's appeal pending the outcome of *Markman*, which had been argued and submitted to the court more than nine months earlier. U.S. Surgical also made the point that resort to Federal Circuit Rule 36 was totally inappropriate in light of the highly meritorious issues that it had raised on appeal, including the very same issue *sub judice en banc* in *Markman*. The CAFC denied U.S. Surgical's petition without comment on March 23, 1995. App. 32a.

Less than two weeks later, on April 5, 1995, the CAFC issued its long-awaited *en banc* decision in *Markman*. Eight of the eleven active judges ruled that claim construction was a matter of law *exclusively* for the court, in accordance with the *Read* line of cases. 34 USPQ2d at 1332. "We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and the obligation to construe as a matter of law the meaning of language used in the patent claim." 34 USPQ2d at 1329.

Circuit Judge Newman, who had chaired the panel in U.S. Surgical's appeal, filed an extensive dissent. She amplified on her view, as expressed in her overruled *Tol-O-Matic* opinion, that the jury had a significant role in claim construction. 34 USPQ2d at 1346-68. Circuit Judge Rader, who had joined Judge Newman's opinion in *Tol-O-Matic*, concurred in the judgment; however, he saw no need to reach the issue decided by the *Markman en banc* majority. 34 USPQ2d at 1345-46. Circuit Judge Mayer, whose views on the role of court and jury were similar to Judge Newman's, also concurred in the judgment. 34 USPQ2d at 1337-45.[6]

In *Markman*, the CAFC *en banc* decisively rejected the *Tol-O-Matic* line of cases. The *Markman* holding that claim construction is a matter of law exclusively for the court is exactly the position that U.S. Surgical advocated in the trial court and on appeal, only to have its position rejected on appeal because the active judges randomly assigned to its panel (Newman, Rader, JJ.) happened to be two of only three active CAFC judges not in agreement with the *Read* line of cases and the *Markman* majority. Their determination not to bow to their colleagues was underscored further when they refused to apply *Markman* in *Pirkle v. Ogontz Controls Co.*, No. 94-1454 (April 6, 1995). *Pirkle* was argued on the very day that the *Markman* decision was released, and was summarily affirmed the next day. Circuit Judges Newman and Rader again invoked Federal Circuit Rule 36 to avoid issuing a decision explaining their refusal to apply *Markman*.[7]

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[6] The third member of the *U.S. Surgical* panel, Senior Circuit Judge Bennett, and the third member of the *Tol-O-Matic* panel, Senior Circuit Judge Skelton, did not participate in the *Markman en banc* decision due to their senior status.

[7] The *Pirkle* panel consisted of Newman and Rader, JJ. and Senior Circuit Judge Skelton, the same panel that decided *Tol-O-Matic*. Counsel for Pirkle was unaware that *Markman* was being released on the day of his argument. In his petition for rehearing

REASONS FOR GRANTING THE WRIT

I. THIS COURT SHOULD RESOLVE, ONCE AND FOR ALL, THE RESPECTIVE ROLES OF COURT AND JURY IN DECIDING THE MEANING OF PATENT CLAIMS

The single most important issue in a jury-tried patent case is the proper role of court and jury in deciding the meaning of patent claims. This issue is present in every jury patent case in which the alleged infringer disputes the meaning of words and phrases in a patent claim, that is, in virtually every jury patent case. The issue is of vital importance because correct claim construction is the crucial first step in both infringement and obviousness analyses.[8] Federal trial courts often have submitted issues of claim interpretation to the jury rather than instruct the jury on the meaning of the claim. That is precisely what occurred in this case, as well as in *Markman*.

In her dissent from the CAFC's denial of rehearing *en banc* of the panel decision in *In re Lockwood*, 33 USPQ2d 1907, 1908 (Fed. Cir. 1995), *cert. granted*, 63 U.S.L.W. 3857 (June 6, 1995), Judge Nies wrote: "No more important nor contentious issue arises in patent law jurisprudence than the appropriate role of juries in patent litigation." It is of paramount importance that this Court authoritatively settle the role of court and jury in ascertaining the meaning of patent claims. This issue has arisen far more frequently, and is of greater national importance than the *Lockwood* issue, which involves the

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Pirkle protested that the Rule 36 disposition "would appear to have been a clerical mistake," but the petition was denied. (Senior Judge Skelton voted to rehear.) Counsel for Pirkle has advised that Pirkle plans to file a petition for *certiorari* by mid-July, well in advance of its due date of August 22, 1995.

[8] Alleged obviousness under 35 U.S.C. § 103 is surely the most common invalidity defense.

role of court and jury in a patent declaratory judgment action seeking an invalidity declaration.[9]

For the reasons set forth in Chief Judge Archer's *Markman* opinion, it is important that the trial court construe the claims as a matter of law for the jury. It should do so through meaning-specific instructions that review for the jury the exact meaning of each claim element, as U.S. Surgical requested. A jury is not in a position to determine either infringement or obviousness if it is not properly charged on the meaning of the claims. It was no surprise that the jury below called for a dictionary; it was adrift and sorely in need of direction.

When the claims are not construed at all for the jury, as occurred in the District Court, then the risk is that issues of infringement and obviousness are decided by the jury totally devoid of the legal guidance needed for rational decision-making. With respect to infringement, the jury cannot perform its role of determining whether the accused device infringes because the claim has not been construed for the jury to compare the accused device to the correctly construed claim. The same is true for obviousness. The jury cannot properly compare the claim with the prior art unless it knows what the claim means. Claim construction by the court is also the best insurance against the very real danger that a jury will apply one claim meaning in determining infringement but another claim meaning in determining obviousness. See p. 3, *supra*.[10] It is essential to proper patent enforce-

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[9] In *Lockwood*, the question presented is: "In an action in which the sole claim to be tried is a claim under the Declaratory Judgment Act to have a patent declared invalid, is there a right to a jury trial under the Seventh Amendment of the United States Constitution?" Petition for writ of *certiorari*, *American Airlines, Inc. v. Lockwood*, No. 94-1660, p. i.

[10] For example, the jury might apply too narrow a meaning to defeat infringement or, conversely, too broad a meaning to defeat non-obviousness. Its approach also may not be consistent from one claim to another.

ment that a jury apply the same meaning to the claim in both infringement and obviousness analyses.[11]

At its core, the proponents of *Tol-O-Matic*, with considerable justification, perceive that *Markman* means that juries henceforth will have little or no role in most patent cases. On the infringement side, the disputed issue typically relates to the meaning of the claim; once the meaning is fixed, then an accused device either does or does not infringe, with no room in most cases for factual debate. On the obviousness side, the disputed issue also often relates to the meaning of the claim; the other considerations—the scope and content of the prior art and the level of ordinary skill in the art—usually are not disputed. Furthermore, with respect to the obviousness analysis, there is a strong argument that a jury in any event has no constitutional role, as Judge Nies suggests in her *Lockwood* dissent. *In re Lockwood*, *supra*, 33 USPQ2d at 1916.

While the indisputable effect of *Markman* will be to curtail the role of a jury in patent trials, *Markman* also underscores the essential and constitutional role of a Federal judge in patent cases. Even in jury-tried patent cases, the judge must be more than a moderator. As this Court so well stated in *Herron v. Southern Pacific Co.*, 283 U.S. 91, 95 (1931):

> In a trial by jury in a federal court, the judge is not a mere moderator, but is the governor of the trial for purpose of assuring its proper conduct and of

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[11] In *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718 & n.7 (Fed. Cir. 1994), the court stated that a jury, unless properly instructed, functioned as the proverbial "black box into which patents are thrown [to] emerge intact or invalid by an unknown or unknowable process." U.S. Surgical used the "black box" analogy from *Structural Rubber* in its summary of argument in its opening CAFC brief. App. 44a. The purpose was to stress that the jury had no legal guidance on the meaning of the claims from the trial court. Judge Nies in her forceful *Lockwood* dissent also referred to the "black box" analogy. 33 USPQ2d at 1916.

> determining questions of law. This discharge of the judicial function as at common law is an essential factor in the process for which the Federal Constitution provides.

In a jury-tried patent case, a failure to inform the jury what a patent means is no different from a negligence case in which the court provides a highly general charge on negligence but fails to relate the charge to possible alternatives under the facts of a case, so that the jury is faced with abstract concepts of no utility in guiding their deliberations. *E.g., McNello v. Kelly*, 283 F.2d 96, 102 (3d Cir. 1960) ("Few more fundamental errors with respect to a charge can be conceived.").[12] The error is even worse in patent cases, which are often far removed from the experience of most jurors. Also, litigants (especially alleged infringers) in patent cases often are especially disputatious about the meaning of words and phrases in patent claims, and the jury therefore needs clearcut instruction on the meaning of the claims at issue. It is imperative, therefore, that the judge construe patent claims and not leave their construction to the jury.

The CAFC's *en banc Markman* decision is of enormous importance because it clarifies that claim construction must be worked out in advance of instructing the jury, precisely as U.S. Surgical had urged based on the *Read* line of cases. The CAFC correctly reasoned that the jury had no role in claim construction because this process is comparable to statutory interpretation and, therefore, a matter of law strictly for the court. 34 USPQ2d at 1336. *Markman* requires federal trial judges

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[12] Additional examples include *Latsis v. Chandris, Inc.*, 20 F.3d 45 (2d Cir. 1994) (failure to give proper Jones Act instruction), *aff'd*, 1995 WL 352858; *MacEdward v. Northern Electric Co.*, 595 F.2d 105 (2d Cir. 1979) (absence of instructions on key issues). These are "plain error" cases; reversal occurred because of "fundamental error" and despite the absence of properly preserved objections. In contrast, U.S. Surgical submitted meaning-specific instructions and excepted to the court's failure to give them.

to resolve contentions over the meaning of claims in advance of instructing the jury. This represents a "sea change" (as Judge Mayer noted, 34 USPQ2d at 1337) in the approach previously taken by many federal trial judges, including the trial judge in this case. *Markman's* deep and direct effect on the conduct of most patent trials makes it perhaps the single most important patent case decided by the CAFC in its history.

But, as this Court will see when it reviews the petition for *certiorari* in *Markman*,[13] the opposition thereto, and the *amici* briefs expected to be filed, there is strong merit in Judge Mayer's concurring opinion in *Markman* in which he predicts that the CAFC's *Markman* decision "portends turbulence and cynicism in patent litigation." 34 USPQ2d at 1337. Because *Markman* has the effect of severely curtailing jury trials in patent cases,[14] *Markman* will not receive general acceptance unless and until this Court agrees that it correctly defines the respective roles of court and jury in resolving disputes over the meaning of patent claims. This important jury question therefore should be resolved definitively by this Court.

If this Court grants *certiorari* in *Markman*, it also should grant *certiorari* in this case, and consolidate it for argument with *Markman*. The record in this case,[15] including the comprehensive instructions that U.S. Surgical

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[13] Counsel for appellant *Markman* has advised undersigned counsel that *Markman* will file a petition for *certiorari* on or before its due date of July 5, 1995.

[14] As Judge Nies points out in her *Lockwood* dissent, the majority of patent cases in recent years (up to 70%) have been tried to a jury. In re *Lockwood*, 33 USPQ2d at 1908 n.1. This will greatly change after *Markman*.

[15] This case presents a clear picture of the failure of the adjudicative process (as exemplified by the jury's request during its deliberations for a dictionary) when the trial court, following *Tol-O-Matic*, declined to give the jury meaning-specific instructions.

provided for the purpose of informing the jury on the claims' meaning, will be of invaluable aid in demonstrating to this Court why it is so important that trial courts define the claims for the jury as a matter of law through meaning-specific instructions. It will make clear that a patentee cannot obtain a meaningful trial when, as in this case, the trial court abdicated its responsibility to inform the jury and functioned merely as a moderator.

Alternatively, if this Court grants *certiorari* in *Markman*, it should hold this case pending the outcome of *Markman*. If *Markman* is affirmed, then *certiorari* should be granted in this case, and this case remanded for further consideration in light of this Court's decision. On the other hand, if this Court denies *certiorari* in *Markman*, then, at that time, it should grant *certiorari* in this case and remand it to the CAFC for reconsideration in light of *Markman*.

II. THE REFUSAL OF THE COURT BELOW TO APPLY ITS OWN *EN BANC MARKMAN* DECISION TO THE INSTANT APPEAL WAS A MARKED DEPARTURE FROM ACCEPTED APPELLATE PRACTICE, REQUIRING AN EXERCISE OF THIS COURT'S SUPERVISORY POWER

For years, the CAFC allowed two lines of precedent to coexist, the *Read* line that promoted proper adjudication of infringement and obviousness in patent cases by requiring the court to construe the patent claim for the jury, and the *Tol-O-Matic* line in which the court, on account of the parties' differing construction of claims, allowed the jury to decide what the claim means with little or (as in this case) no guidance from the court. U.S. Surgical steadfastly urged the *Read* approach. It succeeded at one point in having the District Court declare the *Read* approach to be the proper one, only to find that the new judge assigned to try the case insisted upon following *Tol-O-Matic*.

The CAFC fully appreciated that it needed to resolve the intra-circuit conflict on the role of court and jury in claim construction. It knew that there was no issue more important in jury-tried patent cases. That is why it ordered *en banc* consideration in *Markman*, and solicited additional briefing, including from *amici*. It received new briefs, including from numerous *amici*, in early 1994. It heard argument *en banc* on May 4, 1994. The various opinions in *Markman* show that all active judges regarded the correct delineation of the role of court and jury in claim construction as an issue of great importance.

But then, inexplicably, the CAFC panel assigned to the U.S. Surgical appeal, with the long-awaited *Markman* decision nearing release, refused to apply what soon would emerge publicly as the strong majority view on the claim construction point. Then, when U.S. Surgical requested in its petition for rehearing that its appeal be held until after the *Markman* decision, the Court refused to delay the appeal, notwithstanding, or perhaps because of, U.S. Surgical's strong emphasis on the *Read* case. The panel's summary affirmance and denial of U.S. Surgical's petition for rehearing thwarted petitioner's efforts to have its case decided after the CAFC *en banc* resolved the conflict between *Read* and *Tol-O-Matic*.

The accepted practice of this Court, and of any well-ordered appellate court, when it knows that it has under active *en banc* consideration a case whose outcome directly may affect other cases, is to defer the others pending resolution of the lead case.[16] In this case, the two *Tol-O-Matic* judges, through precipitous action and im-

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[16] For example, this Court deferred consideration of the *certiorari* petition of Montedoro-Whitney Corp. pending the outcome of this Court's decision in *Firstier Mortgage Co. v. Investors Mortgage Insurance Co.*, 111 S.Ct. 648 (1991). It then remanded for reconsideration in light of its decision. *Montedoro-Whitney Corp. v. Marsh-McBirney, Inc.*, 111 S.Ct. 775-76 (1991). This is the accepted appellate practice.

proper invocation of Federal Circuit Rule 36,[17] managed to impose their idiosyncratic views in a summary affirmance. Surely, the panel had an obligation to defer review of U.S. Surgical's appeal in light of the imminent *en banc* resolution of *Markman*. The Rule 36 disposition by the panel had the additional effect of allowing the panel to avoid publishing any reasons for its decision. Under these circumstances, U.S. Surgical could not comply with either the Federal Appellate or Federal Circuit rules for filing rehearing petitions, because it could not identify specific points of law or fact allegedly overlooked or misapprehended by the panel. Fed. R. App. P. 40(a); Fed. Cir. Rule 40(b)(2). The inability to appeal to the CAFC *en banc* is underscored by the *Pirkle* case, in which the CAFC *en banc* declined to intervene despite the panel's refusal to follow *Markman* after *Markman* was decided. See p. 8 and note 7, *supra*. Thus, as a practical matter, Rule 36 effectively cuts off appeal without the possibility of *en banc* review.

The effect of the CAFC's marked departure from accepted appellate practice in suppressing a major appeal on an issue of great concern to the CAFC as a whole was not only to deny U.S. Surgical its appellate rights but to tarnish the fair administration of justice. Petitioner can do no better than to recall the wise words of Chief Judge John R. Brown, when he recoiled at the notion that the Fifth Circuit ever would invoke its counterpart of Federal Circuit Rule 36 "to avoid making a difficult or troublesome decision or to conceal divisive or disturbing issues." *N.L.R.B. v. Amalgamated Clothing Workers*, 430 F.2d 966, 972-73 (5th Cir. 1970). He promised sparing use.[18] *Id.*, and went on to say:

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[17] Needless to say, Rule 36 does not provide for summary affirmance when there is an error of law (as in this case, under the *Read* line of precedents). *See* App. 46a. None of the limited circumstances authorizing the use of Rule 36 arguably existed in this case.

[18] In stark contrast, in the latest six-month period for which compiled data is available (January 1994 through June 1994), the

> The Court itself must be vigilant. We believe we are sensitive now to the factors which would make application of the Rule wrong or unwise or inappropriate. It is the Court's purpose to heed them and in our own survival assure survival of the system we cherish. *Id.*

The panel's refusal to address clearcut conflict in CAFC precedent is, of itself, highly unusual, and a clearcut abuse of Rule 36. But the panel's rush to decide U.S. Surgical's appeal in advance of *Markman*, with Rule 36 as the vehicle, is a truly extraordinary abdication of appellate responsibility. This Court, in the exercise of its supervisory power, should rectify this extreme departure from the usual and accepted appellate practice in this case through summary reversal that requires the CAFC to address the effect of *Markman* upon U.S. Surgical's appeal.[19]

CAFC invoked its Rule 36 to dispose of 44% of all appeals from district courts. Brief for Amicus Curiae Federal Circuit Bar Association, *CPC International, Inc. v. Archer Daniels Midland Co.*, Appeal Nos. 94-145, -1060, 4 Fed. Cir. Bar. J. 269, 294 (1994). The Federal Circuit Bar has criticized the CAFC for its excessive and inappropriate reliance on Rule 36 to avoid reasoned decisions in the face of clearcut conflict in precedent. *See generally id.*, pp. 269-304. This case presents an example of extreme misuse because the conflict in CAFC precedent was well-known to the bench and bar, as evidenced by the District Court's opinion, App. 24a-26a, and the CAFC *en banc* was soon to announce its resolution of the conflict contrary to the District Court's position.

[19] The CAFC then likely will remand to the District Court for a new trial because, unlike in *Markman*, the District Court in this case did not (and in the context of this case could not) render its failure to instruct the jury on the meaning of the claims harmless through its post-trial rulings. See *Markman*, 34 USPQ2d at 1331.

III. THE DECISION BELOW, ALLOWING THE JURY TO USE A NON-EVIDENTIAL DICTIONARY, WAS IN CONFLICT WITH BINDING SECOND CIRCUIT PRECEDENT, AS WELL AS GENERAL FEDERAL AND STATE PRECEDENT CONDEMNING SUCH USE, AND CREATES A DIVISION OF AUTHORITY THAT REQUIRES THIS COURT'S RESOLUTION

On procedural issues, such as the legal effect of a jury's use of extraneous, non-evidential matter in its deliberations, the CAFC defers to the law of the regional Circuit in which the case was tried. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 855-58 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 2957 (1992). In this case, the Second Circuit Court of Appeals is the relevant regional Circuit and, under its leading case, *United States v. Weiss*, 752 F.2d 777, 782-83 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985), the District Court's submission of extraneous matter (the dictionary) to the jury, over the objection of both parties, without any rebuttal of the presumption of prejudice, required a new trial.

The dictionary issue is important because federal courts in patent cases should not be allowed to avoid their obligation to make sure that juries fully understand terms of art in patent cases (*e.g.*, "obviousness" or "presumption" as used in "presumption of validity") through the expedient of providing a jury with a dictionary. On a more general level, the dictionary issue also is important because, until this case, both federal and state courts have been deeply sensitive to the taint that can accrue when the jury is able in effect to make its own law through the unauthorized use of extraneous sources that were not introduced into evidence. Finally, the issue is important because the CAFC should not be allowed to apply its own rule on this type of procedural issue, but should be required to apply the law of the relevant regional circuit.

As set forth in all standard jury instructions, including those used by the trial court in this case, a jury should decide a case *solely* upon the evidence adduced at trial. *Palestroni v. Jacobs*, 77 A.2d 183 (N.J. Super. 1950) (Brennan, J.) (a dictionary case). The presumption of prejudice comes into play because of the jury's use of non-evidential matters in its deliberations. The presumption sometimes can be rebutted, but it is not possible to do so in the absence of a hearing, which the District Court declined to order. *See, e.g., United States v. Weiss*, 752 F.2d at 782-83.

Prior to this case, appellate courts universally have condemned the practice of exposing a jury to dictionaries or any other matter not properly admitted into the record. Indeed, every federal court of appeals that has addressed this issue—other than the court below—considers submission of a dictionary to a deliberating jury to be error.[20] Until now, when exposure to a dictionary results in prejudice, either presumptively or actually, courts have been unanimous as to the result: the judgment is vacated, and a new trial is ordered.[21] This result obtains irrespective

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[20] *See, e.g., United States v. Martinez*, 14 F.3d 543, 548, 550, 552 (11th Cir. 1994) (applying presumption of prejudice); *Mayhue v. St. Francis Hosp.*, 969 F.2d 919, 922-26 (10th Cir. 1992) (presumptively prejudicial); *United States v. Turner*, 936 F.2d 221, 226 (6th Cir. 1991) (use of dictionary "error"); *United States v. Cheyenne*, 855 F.2d 566, 567 (8th Cir. 1988) (use of dictionary "improper jury conduct"); *Marino v. Vasquez*, 812 F.2d 499, 502, 505-07 (9th Cir. 1987) ("reversible error"); *United States v. Duncan*, 598 F.2d 839, 867 (4th Cir.), *cert. denied*, 444 U.S. 871 (1979) (reference to dictionary "misconduct"). State courts agree. *See, e.g., State v. Asherman*, 478 A.2d 227, 252 (Conn. 1984), *cert. denied*, 470 U.S. 1050 (1985) (judge not "authorized to furnish dictionary"); *Wernsing v. General Motors Corp.*, 470 A.2d 802, 809 (Md. 1984) (refusal to grant new trial prejudicial error).

[21] *See, e.g., Martinez*, 14 F.3d at 548, 550, 552; *Mayhue*, 969 F.2d at 922-26; *Marino*, 812 F.2d at 502, 505-07; *Fulton v. Callahan*, 621 So.2d 1235, 1247-50 (Ala. 1993); *Glage v. Hawes Firearms*, 276 Cal. Rptr. 430, 432-38 (Ct. App. 1990); *State v. Abell*, 383

of whether the case is civil or criminal, or whether the source of the dictionary is a juror, the bailiff, or the trial court.[22]

It was obvious error for the District Court to give the jury a dictionary.[23] The parties, of course, instantly recognized that the Court's action was error: both objected, to no avail. Even though the burden was then to Ethicon (as the prevailing party before the jury) to rebut the presumption of prejudice, U.S. Surgical requested a hearing on the jury's use of the dictionary, but the District Court ignored that request. *See* App. 30a-31a. At the trial level, the presumption of prejudice stood unrebutted.

It is of great importance that this Court correct the conflict created by the CAFC's refusal to implement the presumption of prejudice. The decision below not only created a conflict with the Second Circuit, as well as other federal and state precedent, but did so in a context in which the CAFC was obligated by its own precedent to follow the law of the Second Circuit on an important procedural issue. A decision by this Court, eliminating

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N.W.2d 810, 812-13 (N.D. 1986); *Priest v. McConnell*, 363 N.W.2d 173, 179 (Neb. 1985); *Alvarez v. People*, 653 P.2d 1127, 1130-32 & n.11 (Colo. 1982) (*en banc*); *Dongo v. Banks*, 448 A.2d 885, 888-89 (Me. 1982); *Creasey v. Hogan*, 637 P.2d 114, 122-25 (Or. 1981); *State v. Holmes*, 522 P.2d 900, 905 (Or. App. 1974); *Gertz v. Bass*, 208 N.E.2d 113, 115-17 (Ill. App. 1965); *Smith v. State*, 95 So.2d 525, 527-28 (Fla. 1957); *Palestroni v. Jacobs*, 77 A.2d 183, 184-86 (N.J. Super. 1950). All of these cases are "dictionary" cases.

[22] The court furnished the dictionary or a dictionary definition in *Dongo*, *Creasey*, *Holmes*, *Smith*, and *Palestroni*, all of which are cited in note 21, *supra*. The facts of *Holmes* are the same as those in this case. Both counsel objected. The court gave the jury the dictionary anyway. The court made no inquiry into the jury's need. The appellate court presumed prejudice and ordered a new trial. 522 P.2d at 905.

[23] It is certainly understandable that the jury asked for a dictionary. It had not been instructed on the meaning of the claims. Its request underscores the degree to which it was unguided.

the conflict created by the courts below, will enhance materially the uniformity and predictability in the law.

IV. THE CAFC'S INVOCATION OF FEDERAL CIRCUIT RULE 36 TO AVOID THE DICTIONARY ISSUE SO FAR DEPARTED FROM THE ACCEPTED AND USUAL COURSE OF JUDICIAL PROCEEDINGS AS TO CALL FOR AN EXERCISE OF THIS COURT'S POWER OF SUPERVISION

On appeal, U.S. Surgical, which had briefed the dictionary issue carefully, dwelled on it in oral argument because it was crystal clear that the only outcome under controlling Second Circuit authority, *United States v. Weiss*, *supra*, as well as other federal (and state) precedent, was for the CAFC to remand for a new trial. Yet, the panel, improperly invoking Federal Circuit Rule 36 to affirm the judgment,[24] conveniently swept a point of presumptively prejudicial error under the rug. It thereby avoided its obligation of judicial review. Such use of summary affirmance deprives a litigant of its right to meaningful appellate review. It also undermines public and party confidence in the judicial system.[25]

Summary affirmance rules like Federal Circuit Rule 36 may have a proper role, but this Court should make certain that these rules are not abused to avoid proper appellate review. The essential purpose of an appeal is to provide a litigant advancing a clear, legally-based claim with an explanation for the affirmance or reversal of that claim. Indeed, it is not too much to say

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[24] See note 17, *supra*. The dictionary issue, presently an issue of law, does not remotely come within any of the five circumstances allowing for summary affirmance. *See* App. 46a.

[25] The legal profession generally agrees "that it is important for the courts at least to issue memoranda so that they do not give the appearance to litigants of acting arbitrarily . . . ." Commission on Revision of the Federal Appellate System, Structure and Internal Procedures: Recommendations for Change, p. 49 (June 1975).

that litigants presenting such claims have a strong and legitimate expectation that they will receive written explanations in support of affirmance or reversal. *See N.L.R.B. v. Amalgamated Clothing Workers, supra,* 430 F.2d at 972-73 (Brown, C.J.).

It has been clear to the Federal Circuit Bar for some time that the CAFC has been using Federal Circuit Rule 36 to avoid its obligation of judicial review. *E.g.*, N. Dodell, *On Wanting To Know Why,* 2 Fed. Cir. Bar J. 465, 466 (1992). But the panel's invocation of Rule 36 to avoid consideration of the dictionary issue, with not only clear error but *presumptively prejudicial* error working in U.S. Surgical's favor, constitutes a unique departure from the legitimate norms of appellate decision-making. What happened below should be of gravest concern to this Court as overseer of the administration of justice in the federal court system.[26] This Court should exercise that power by granting the petition for *certiorari* and remanding to the CAFC for reconsideration of the dictionary issue in light of the presumption of prejudice as set forth in *United States v. Weiss, supra.*

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[26] It is difficult enough to provide meaningful advice to a client about a client's chances on appeal, but the task becomes impossible if a federal appellate panel may simply ignore a presumption of prejudice in favor of an appellant.

CONCLUSION

For the reasons set forth above, this Court should grant this petition for *certiorari* on the *Markman* and dictionary issues, and consolidate this case with *Markman*, whose *certiorari* petition also should be granted. If *certiorari* is denied in *Markman*, this Court should grant *certiorari* on the dictionary issue. Alternatively, if *certiorari* is denied in *Markman*, this Court should grant *certiorari* in this case and remand for reconsideration in light of the Federal Circuit's decision in *Markman*. At the same time, it should also remand for reconsideration of the dictionary issue in light of *United States v. Weiss*, *supra*.

Respectfully submitted,

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APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

94-1386, -1419

UNITED STATES SURGICAL CORPORATION,
Plaintiff-Appellant,

v.

ETHICON, INC. AND JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants/Cross-Appellants.

JUDGMENT

On Appeal from the United States District Court
for the District of Connecticut in Case Nos(s).

92-CV-134

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED. *See* Fed. Cir. R. 36.

Per Curiam (NEWMAN, *Circuit Judge*, BENNETT, *Senior Circuit Judge*, and RADER, *Circuit Judge*).

ENTERED BY ORDER OF THE COURT

/s/ Francis X. Gindhart
FRANCIS X. GINDHART
Clerk

Dated Feb. 14, 1995

APPENDIX B

[Filed Jun. 7, 1994]

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF CONNECTICUT

Civ. No. 5:92CV00134(AVC)

UNITED STATES SURGICAL CORPORATION

vs.

ETHICON, INC. and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.

RULING ON POSTTRIAL MOTIONS

This is a patent infringement action in which the plaintiff, United States Surgical Corporation (U.S. Surgical), claims that the Endoscopic Multiple Clip Applier (EMCA) and the Endoscopic Rotatable Clip Applier (ERCA) manufactured and sold by the defendants, Ethicon, Inc. and Johnson & Johnson Hospital Services (Ethicon), infringe upon claim 1 of the '420 patent [1] and claims 1, 2, and 7 of the '057 patent,[2] both owned by U.S. Surgical. On January 12, 1994, the parties tried to a jury the issue of liability. On February 16, 1994, the jury returned a verdict for Ethicon, finding: (1) that the ERCA and

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[1] Patent number 5,100,420, issued by the Patent and Trademark Office (PTO) to Green et al. (U.S. Surgical, assignee), on March 31, 1992.

[2] Patent number 5,084,057, issued by the PTO to Green et al. (U.S. Surgical, assignee) on January 8, 1992.

EMCA infringed upon claim 1 of the '420 patent, both literally and under the doctrine of equivalents; (2) that the ERCA and EMCA did not infringe upon claims 1, 2, and 7 of the '057 patent; and (3) that claim 1 of the '420 patent, as well as claims 1, 2, and 7 of the '057 patent, were invalid due to obviousness. Accordingly, on February 18, 1994, the court rendered judgment for Ethicon.

U.S. Surgical now moves for judgment notwithstanding the verdict as to the jury's finding of non-infringement of claims 1, 2 and 7 of the '057 patent and as to the jury's finding of invalidity of each of the patent claims at issue. In the alternative, U.S. Surgical moves for a new trial as to those issues, asserting: (1) that the jury's verdict was contrary to the weight of the evidence; and (2) that legal error occurred at trial to U.S. Surgical's prejudice. Ethicon moves for judgment notwithstanding the verdict as to the jury's finding of infringement of claim 1 of the '420 patent, and, in the alternative, for a new trial on that issue.

FACTS

The evidence at trial established the following facts, which are recounted in brief.

The instruments at issue in this action are endoscopic multiple clip appliers, which are used to ligate, or close, internal vessels or arteries during endoscopic surgery. Endoscopic surgery is minimally invasive surgery where doctors perform the surgical operation through small incisions, using sealed tubes, or trocars, to facilitate the entry of surgical instruments into the patient's insufflated abdomen.[3] A tiny camera can also be inserted through the trocars. Surgeons manipulate the endoscopic instru-

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[3] Insufflation is the process by which gas is pressured into the abdomen, causing the abdominal cavity to expand, thereby creating a working space for the endoscopic surgeons.

ments while monitoring their movements on a video screen.

Both U.S. Surgical and Ethicon manufacture surgical instruments, including instruments for endoscopic surgery. In 1966, U.S. Surgical received its first patents for mechanical wound closure devices.[4] By 1979, U.S. Surgical manufactured and sold automatic multiple clip appliers for use in open, or conventional, surgery.[5] Beginning in approximately 1980, Ethicon also manufactured and sold multiple clip appliers for conventional surgery. By July 1989, when U.S. Surgical applied for a patent for its endoscopic multiple clip applier, the Patent and Trademark Office (PTO) had issued at least 10 different patents for multiple clip appliers for conventional surgery. Several companies manufactured and sold approximately 40 different versions of the conventional multiple clip appliers.

As for clip appliers for use in endoscopic surgery, prior to January 1990, when U.S. Surgical introduced for commercial use its Endoclip endoscopic multiple clip applier, only single clip appliers were available for endoscopic surgery. Endoscopic single clip appliers had to be inserted and then withdrawn through a trocar in order to apply each surgical clip. By July 1989, the PTO had issued several patents for various single clip appliers for use in endoscopic surgery, and at least three different companies manufactured and sold different versions of an endoscopic single clip applier.

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[4] Begining in approximately 1966, U.S. Surgical began to manufacture and sell the first surgical clip appliers in the United States. The use of surgical clips eventually replaced, to a substantial degree, the use of sutures for ligation during surgery.

[5] In May 1979, the PTO issued to U.S. Surgical patent number 4,152,920, which disclosed a multiple clip applier for open surgery.

In mid-1987, U.S. Surgical began to develop a multiple clip applier for endoscopic surgery.[6] From approximately May 1987 through July 1989, U.S. Surgical personnel developed and tested a multiple clip applier for endoscopic surgery. On July 18, 1989, U.S. Surgical applied for a patent for its endoscopic multiple clip applier, which application ultimately resulted in the issuance of the '420 patent. On May 30, 1990, U.S. Surgical filed a further patent application, a continuation in part of the July 18, 1989 application, which ultimately resulted in the issuance of the '057 patent. In January 1990, U.S. Surgical first made the Endoclip commercially available. On January 28, 1992, the PTO issued the '057 patent. On March 31, 1992, the PTO issued the '420 patent.

Prior to 1989, the use of endoscopic surgery was largely limited to gynecological surgery, specifically, the ligation of fallopian tubes. In October 1989, at the American College of Surgeons convention, U.S. Surgical, at their convention "booth", displayed on videotape an endoscopic gallbladder removal. The endoscopic gallbladder removal demonstrated at the convention employed various U.S. Surgical endoscopic instruments, including the Endoclip. The operation also employed micro-camera technology which allowed the surgeon to monitor his movements on a video screen. From approximately October 1989 through 1993, the use of endoscopic surgery for gall bladder removals increased dramatically.[7] With the increase in

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[6] As early as 1985, U.S. Surgical personnel had discussed the development of an endoscopic multiple clip applier, but significant design and engineering work did not begin until 1987.

[7] At trial, the parties and their witnesses contested the reasons underlying the huge increase in the use of endoscopic surgery. Ethicon presented expert testimony that the "endoscopic revolution" was best attributed to the micro-camera technology which allowed the precise endoscopic procedures to be monitored by the surgeon, as first demonstrated at the October 1989 American

endoscopic surgical procedures, the U.S. Surgical Endoclip achieved considerable commercial success.

On or about May 1990, Ethicon began to develop its own endoscopic multiple clip applier. In July 1991, Ethicon made the EMCA commercially available. In October 1991, Ethicon made the ERCA commercially available. On March 10, 1992, U.S. Surgical initiated this action, alleging patent infringement, claiming that Ethicon's EMCA and ERCA infringed upon the '057 and '420 patents.

At trial, U.S. Surgical presented evidence concerning its development of its endoscopic multiple clip applier, the prosecution and granting of the '057 and '420 patents, and the success of the commercial embodiments of the U.S. Surgical invention. U.S. Surgical also presented the testimony of both a mechanical expert, Stephen Tricamo, and a patent law expert, Rene Tegtmeyer, concerning: (1) their interpretation of the patent claims at issue; (2) their conclusions that the EMCA and ERCA infringe upon the patent claims at issue, and their analysis supporting that conclusion; and (3) their conclusions that the U.S. Surgical patents were valid. Ethicon presented evidence concerning its development of the EMCA and ERCA, as well as evidence concerning prior art relevant to the field of endoscopic surgical instruments. Ethicon also presented expert testimony from a mechanical expert, Robert Mann, and a patent law expert, James Ryther, concerning: (1) their interpretation of the patent claims at issue; (2) their conclusions that the EMCA and ERCA do not infringe upon the U.S. Surgical patent claims, and their analysis supporting that conclusion; and (3) their conclusions, based on the prior art, that the U.S. Surgical patents were invalid due to obviousness.

College of Surgeons convention. U.S. Surgical, on the other hand, attributed the increase in endoscopic gallbladder removals to the availability of its endoscopic multiple clip applier.

On February 16, 1994, the jury returned its verdict for Ethicon.

STANDARD

In order to succeed on a motion for judgment notwithstanding the verdict (JNOV), the moving party must establish that the jury's findings are not supported by substantial evidence in the record. F.R.C.P. 50(a)-(b). "Substantial evidence is more than a mere scintilla. It means such evidence as a reasonable mind might accept as adequate to support a conclusion." *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 859 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 2957 (1992), *quoting Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938). Further, the court must determine whether the jury's "findings can support the legal conclusions necessarily drawn by the jury in accord with its instructions enroute to its verdict." *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984). In determining a motion for JNOV, the court must: "(1) consider all the evidence; (2) in a light most favorable to the non-mover; (3) drawing reasonable inferences favorable to the non-mover; (4) without determining credibility of witnesses; and (5) without substituting its choice for that of the jury between conflicting testimony." *Medtronic Inc. v. Intermedics, Inc.*, 799 F.2d 734, 742 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1033 (1987), *citing Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

The court, in its discretion, may grant a motion for a new trial brought pursuant to F.R.C.P. 59 if it concludes that: (1) "the verdict is against the weight of the evidence," *New Idea Farm Equip. Corp. v. Sperry Corp.*, 916 F.2d 1561, 1565 (Fed. Cir. 1990); (2) prejudicial error occurred during trial, *id.*; or (3) substantial justice has not been done, *Hugh v. Jacobs*, 961 F.2d 359, 365 (2d Cir. 1992). 11 C. Wright & A.

Miller, Federal Practice & Procedure § 2803, at 32 (1973 & Supp. 1986). "A district court ordinarily should not grant a new trial unless it is convinced that the jury reached a seriously erroneous result or that the verdict is a miscarriage of justice." *Hugh*, 961 F.2d at 365. In determining whether the verdict is against the weight of the evidence, the court "has wide discretion and may consider the credibility of witnesses and [independently] weigh the evidence." *Moxness Prods., Inc. v. Xomed, Inc.*, 891 F.2d 890, 893 (Fed. Cir. 1989).

DISCUSSION

A. Patent Infringement

In order to determine patent infringement, both literally and under the doctrine of equivalents, the court instructed the jury to compare the EMCA/ERCA with the patent claims at issue. Because the parties disputed the meaning of the patent claims and presented conflicting evidence on their proper interpretation, thereby creating "an underlying factual question," the court instructed the jury to interpret the claims "en route to deciding the issue of infringement." *Tol-o-matic v. Proma Produkt-Und Marketing*, 945 F.2d 1546, 1550 (Fed. Cir. 1991) ("The interpretation of claims is defined as a matter of law based on underlying facts.").[8] Therefore, in addition to reviewing, for substantial evidence, the jury's factual findings concerning infringement, the court, upon motion for JNOV, will review the jury's verdict "to ascertain whether reasonable jurors could have interpreted the claim[s] in such a way that supports the verdict." *Id.* (citing cases). "In moving to set aside the jury's [infringement] verdict, [the movant] must show either that the jury's findings of disputed material facts are not supported by substantial evidence, or that those findings cannot support the legal conclusions to be implied from the verdict." *Mars, Inc. v. Conlux USA Corp.*, 818 F. Supp. 707, 711 (D. Del.

[8] *See* discussion, *infra* § C.1.

1993) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984)).

Here, in their motions for JNOV, both parties challenge that portion of the jury's infringement verdict adverse to its position at trial.

1. *Infringement of Claim 1 of the '420 Patent*

Claim 1 of the '420 patent is a combination claim which describes, in pertinent part, an endoscopic clip applier which includes "a plurality of surgical clips" and a "clip closing means for sequentially closing said surgical clips," to be used in combination with a trocar, which includes a "valve means for sealing" the cannula of the trocar.

Ethicon contends that, as a matter of law, the EMCA and ERCA do not infringe upon claim 1 of the '420 patent. Ethicon argues that the Ethicon clip applier (EMCA/ERCA) and Ethicon Endopath trocar do not include every element of claim 1, because: (1) the Ethicon devices do not include the "valve means for sealing" described in the claim; and (2) the Ethicon EMCA and ERCA do not "sequentially close clips" within the meaning of the claim. Ethicon also contends that U.S. Surgical failed to prove infringement under the doctrine of equivalents.

a. *"valve means for sealing said cannula"; "said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith."*

Ethicon contends that the interpretation of the "valve means" claim limitation was not in dispute at trial, and that, "whether viewed as a means-plus-function element or a structure element," the language of the claim "as a matter of law requires the valve in the trocar cannula to

be in sealing engagement with the clip applier." [9] Ethicon argues that the Endopath trocar has both a flapper valve, which seals the cannula only when there is no instrument in the cannula, and a gasket, which seals the cannula when the EMCA/ERCA is inserted. Because the claim requires that the clip applier be "insertable through said valve means in sealing engagement therewith," Ethicon argues that its device does not infringe because the *valve* in the Ethicon trocar is never in sealing engagement with the clip applier.

U.S. Surgical, in response, asserts that Ethicon's argument—that the Endopath *valve* is not in sealing engagement with the clip applier—requires the court to ignore the actual language of the claim. The language of claim 1 requires that the clip applier be in sealing engagement with "the valve means," not the valve. U.S. Surgical contends that substantial evidence at trial supported the contention that the "valve means" claim language describes generally the structures used to prevent gas leakage while instruments are inserted or withdrawn through the trocar, not only a valve. Therefore, the "valve means" in Ethicon's trocar consist of both the flapper valve, and the gasket.

The court agrees. Substantial evidence at trial supported the conclusion that the claim language "through said valve means in sealing engagement therewith" did not require the inserted clip applier to be in sealing en-

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[9] Ethicon Memorandum in Support of Motion for JNOV, at 4. At trial, Ethicon successfully argued that the meaning of the patent claims in this action was in dispute and that the interpretation of the claims was to be submitted to the jury. In its motion for JNOV, Ethicon nonetheless contends that the meaning of certain claim language was not in dispute, and that the court was required to instruct the jury on the meaning of those terms. Ethicon did not request any such instruction to the jury on the interpretation of claims at any time prior to its motion for JNOV. The posttrial briefs in this action indicate that Ethicon's new and inconsistent position is incorrect. *See infra* § C.1.

gagement with the flipper valve in the Ethicon trocar, Rather, the clip applier, in order to infringe, must be in sealing engagement with the Ethicon trocar's "valve means," which includes both the valve and the gasket. Substantial evidence supports the jury's conclusion that the Ethicon trocar and EMCA/ERCA infringed the "valve means" claim element.

b. *"an endoscopic clip applier having" "clip closing means for sequentially closing [a plurality of] surgical clips"*

Although Ethicon requested at trial that the court submit to the jury the issue of claim interpretation, it now asserts that, as a matter of law, the "means for sequentially closing" clips must be construed to incorporate the clip advancing means disclosed in U.S. Surgical's patent specifications. Unlike the other patent claims at issue, claim 1 of the '420 patent does not include any claim limitation concerning the means for advancing surgical clips through the endoscopic shaft to the jaws which fasten the clips.[10] Rather, claim 1 of the '420 patent describes the combination of a trocar and an endoscopic clip applier that includes: (1) a frame; (2) a plurality of surgical clips disposed in any array and clip closing means for sequentially closing clips; and (3) a seal means. Ethicon argues that the clip advancing means described elsewhere in the '420 patent must be implied

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[10] Each of claims 1, 2 and 7 of the '057 patent include claim limitations concerning the means for advancing surgical clips. *See* claim 1, '057 patent ("(b)(ii) means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped"); claim 2 (dependent claim which incorporates the limitations of claim 1, above); claim 7 ("(b)(iii) means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped"). Accordingly, the jury found infringement of claim 1 of the '420 patent, but non-infringement as to each claim of the '057 patent.

as a claim limitation inherent in claim 1.[11] Implying that the clip advancing means is a limitation to claim 1, Ethicon contends that the advancing means in the EMCA/ERCA are not the equivalent of the advancing means disclosed in the specifications of the '420 patent. Ethicon further asserts that the clip closing means—or "jaws"—in the EMCA/ERCA are not the equivalent of the jaws disclosed in the '420 patent.[12]

U.S. Surgical, in response, contends that substantial evidence supported the jury's conclusion that the clip advancing means of the patented device were not an inherent claim limitation of claim 1 of the '420 patent, notwithstanding the use of the word "sequentially" in the patent claim. Further, U.S. Surgical argues that substantial evidence supported the jury's conclusion that the jaws of the ERCA/EMCA are equivalent in structure to the jaws disclosed in the '420 specification.

The court concludes that substantial evidence supported both the jury's interpretation of this claim element and the jury's conclusion that the EMCA/ERCA infringed upon this claim element. The jury's finding, implicit in its

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[11] Ethicon argues that the clip advancing means is implied in claim 1 because: (1) a clip advancing structure is necessary in order to fulfill the essential function of the instrument described—to place numerous surgical clips during a single entry through a cannula; and (2) the use of the word "sequentially" in claim 1 references the "sequence" described throughout the '420 patent and the '057 patent, such sequence including the advancement of clips into the jaws of the clip applier.

[12] In support of its contention that the EMCA/ERCA does not satisfy the claim limitations of this claim element, Ethicon also asserts: (1) that the EMCA/ERCA does not perform the disclosed function of "sequentially closing" multiple clips, because the word "sequential" implicitly requires semi-automatic operation as a claim limitation; and (2) that the "issuance of Ethicon's '247 and '249 patents in and of itself requires a finding of non-infringement of the clip closing means." The court concludes that these grounds for JNOV lack merit.

verdict on infringement, that claim 1 of the '420 patent did not include clip advancing means, is supported by substantial evidence. U.S. Surgical presented substantial evidence concerning the patent's prosecution history, as well as expert testimony, that support the jury's interpretation of "clip closing means." The court concludes that the jury correctly interpreted this claim, so as not to include "clip advancing means" as an implicit limitation of claim 1. Accordingly, the determination of infringement of claim 1 does not require a finding that the EMCA/ERCA's clip advancing means were equivalent to those discolsed in the '420 patent.

The court further concludes that substantial evidence supported the jury's finding that the EMCA/ERCA jaws were equivalent to the jaws disclosed in the '420 patent specification. The evidence established that the Ethicon jaws were narrower so as to fit through a cannula without closing. The fact that the Ethicon jaws performed slightly differently, or performed an additional function (insertion without closing), does not negate infringement of the patented claim. *See, e.g., Texas Instruments v. U.S. Intern. Trade Com'n,* 805 F.2d 1558, 1563-64 (Fed. Cir. 1986); *Amstar Corp. v. Envirotech Corp.,* 730 F.2d 1476, 1482 (Fed. Cir.) (quoting *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F.2d 381, 402 (10th Cir. 1965), *cert. denied,* 383 U.S. 933 (1966)) ("infringement cannot be avoided by the mere fact that the accused device is more or less efficient or performs additional functions"), *cert. denied,* 469 U.S. 924 (1984).

c. *Infringement under the Doctrine of Equivalents*

Ethicon also moves for JNOV concerning the jury's verdict of infringement under the doctrine of equivalents. As to claim 1 of the '420 patent, the jury found that the Ethicon EMCA/ERCA and Endopath trocar performed the same function, in the same way, and to

achieve the same result, as the invention in claim 1 of the '420 patent.

Ethicon first contends that, as a matter of law, the court should not have allowed the jury to consider the issue of infringement under the doctrine of equivalents. As it did at trial, Ethicon argues that the "application [of the doctrine of equivalents] was not appropriate unless the court made a threshold finding that Ethicon copied or stole the patented invention or otherwise perpetrated a fraud on the patent." The cases upon which Ethicon relies do not support the rule proposed.[13] Al-

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[13] The Federal Circuit cases cited by Ethicon do not support the proposition that the trial court must make a threshold determination of copying or misappropriation before submitting the doctrine of equivalents to the jury, or before entering a judgment under the doctrine of equivalents. In *Charles Greiner & Co. v. Mari-Med Mfg. Inc.*, 962 F.2d 1031, 1035-37 (Fed. Cir. 1992), the Federal Circuit discussed the equitable origin of the doctrine of equivalents, which is designed to prevent "fraud on the patent," and also stated that the doctrine must not be applied in a way that ignores the legal significance of claim limitations. In *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991), the court, in affirming the district court's summary judgment ruling, stated that the doctrine of equivalents should not operate to expand the protective scope of patent claims. The court also noted that the doctrine is designed to prevent infringers who "merely make[] an insubstantial change [to a patented device]." *Id.* In *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993), which also did not involve a jury trial, the court stated: "[T]he Supreme Court refused to allow an 'unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim.' (citing *Graver Tank*, 339 U.S. at 607 (1950)). This statement elucidates both the purpose of the doctrine and the type of conduct which triggers its application. An equivalent under the doctrine of equivalents results from an insubstantial change which, from the perspective of one of ordinary skill in the art, adds nothing of significance to the claimed invention." Here, the court concluded that the evidence in this case sufficiently "triggered" the doctrine of equivalents, and instructed the jury on both the purpose of the doctrine and how to apply it.

though the doctrine of equivalents should not be "simply the second prong of every infringement charge," *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1036 (Fed. Cir. 1992), quoting *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed Cir. 1991), it should be applied to ensure that one does not avoid infringement by making only "an insubstantial change which, from the perspective of one of ordinary skill in the art, adds nothing of significance to the claimed inventoin." *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993). The jury properly considered infringement under the doctrine of equivalents in this case.

Ethicon contends that the sealing structures in its trocar—the valve and gasket—perform a function different from the patented invention, and do so in a different way. Ethicon argues that the jury could only conclude that its valve and gasket was a substantially equivalent "valve means" if it ignored the claim limitation, i.e., "*valve* means." Further, Ethicon asserts that U.S. Surgical failed to adduce evidence to support a particularized showing as to "how" and "why" the Ethicon devices performed in a substantially similar "way" as the patented invention.

For the reasons discussed above, *supra* § A.1.a, the court rejects Ethicon's contention that the Ethicon valve and gasket perform a substantially different function, in a different way, than the "valve means" described in claim 1. Further, the record discloses that U.S. Surgical adduced substantial evidence at trial concerning how and why the Ethicon devices performed in the same way as the patented invention. It was proper for certain witnesses to explain how the "way" prong of the doctrine of equivalents was satisfied by referring to earlier testimony pertaining to literal infringement analyses, provided that there was "testimony explicitly comparing the claimed and accused devices as to all three elements of equivalents." *Lear Siegler, Inc. v. Sealy Mattress Co.*

of Mich., 873 F.2d 1422, 1426 (Fed. Cir. 1989) (party asserting infringement must present evidence and argument concerning the doctrine and each of its elements).

Accordingly, the court concludes that substantial evidence supported the jury's conclusion that claim 1 of the '420 patent was infringed under the doctrine of equivalents. Further, "in the interest of judicial economy and conservation of the parties' resources," the court will permit the jury's verdicts of both literal infringement and infringement under the doctrine of equivalents to stand pending appeal. *See, e.g., Goodwall Constr. Co. v. Beers Constr. Co.*, 991 F.2d 751, 754 (Fed. Cir. 1993).

Because the record provides substantial support for the jury's finding of infringement of Claim 1 of the '420 patent, both literally and pursuant to the doctrine of equivalents, as discussed above, the court denies Ethicon's motion for JNOV. The court also denies Ethicon's motion for a new trial on the issue of infringement of claim 1 of the '420 patent.

2. *Verdict of Non-infringement of Claims 1, 2, and 7 of the '057 patent*

U.S. Surgical moves for JNOV, or in the alternative, for a new trial, as to the jury's verdict that claims 1, 2, and 7 of the '057 patent were not infringed.

Claims 1, 2, and 7 of the '057 patent each disclose an endoscopic multiple clip applier. As discussed above, claims 1, 2, and 7 of the '057 patent each contain at least one critical claim element which is not contained in claim 1 of the '420 patent. Each claim includes a means-plus-function claim element concerning the means for individually advancing multiple surgical clips through the endoscopic section of the clip applier and into a pair of jaws at the end of the instrument.[14] Because of these

[14] Specifically, claim 1 of the '057 patent discloses an endoscopic multiple clip applier, that includes: "ii) means for individually

clip-advancing claim elements, in order for the jury to conclude that claims 1, 2, and 7 were infringed, it had to find that: (1) the EMCA/ERCA performs the identical function called for by the claim element (individually advancing clips into the jaws); *and* (2) the structures which perform that function in the EMCA/ERCA are identical to, or the equivalent of, the structures described in the U.S. Surgical patent specifications to perform that function. 35 U.S.C. § 112; *Valmont Indust.*, 983 F.2d at 1042.

Both U.S. Surgical and Ethicon presented considerable evidence concerning the strictures disclosed in the U.S. Surgical patents that performed the clip advancing function, and whether the clip advancing structures in the ERCA/EMCA constituted "the equivalent" of those structures.[15] Substantial evidence in the record supports the jury's finding that the EMCA/ERCA's clip advancing structures were not the equivalent of the structures dis-

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advancing [multiple] clips to the distal portion of said endoscopic means for positioning adjacent to the body tissue to be clipped;" and "iii) means for at least partially closing each said clip at least sufficient to grip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means." Claim 2 is a dependent claim, which incorporates all of the claim elements of claim 1, including those quoted above. Claim 7 discloses a disposable endoscopic multiple clip applier, that includes: "iii) means for individually advancing [multiple] clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped;" and "iv) means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue."

[15] For example, Ethicon's witnesses contended that its "fully "semi-automatic" structures disclosed in U.S. Surgical's patents automatic" clip advancing structures were not the equivalent of the specifications. U.S. Surgical's witnesses disagreed. Ethicon's witnesses contended that the EMCA/ERCA clip advancing means, which included a "feed bar, two plane clip track, lifter spring, and escapement" were not the equivalent of the one plane pusher bar disclosed in the U.S. Surgical patent. U.S. Surgical's witnesses disagreed.

closed in the U.S. Surgical patents to perform the function of advancing clips.[16] Accordingly, U.S. Surgical's motion for JNOV as to infringement of claims 1, 2, and 7 of the '057 patent, both literally and under the doctrine of equivalents, is denied. The court also denies U.S. Surgical's motion for a new trial on this issue.

B. Patent Invalidity

Pursuant to 35 U.S.C. § 103, an "obvious" patent claim is invalid and unenforceable. A patent claim is obvious if "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. The determination of obviousness is classified as a legal conclusion that relies on a number of "factual underpinnings," [17] namely: (1) invention; (2) the differences between the prior art and the patent claims at issue; and (3) the level of ordinary skill in the art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "Secondary considerations," including commercial success, long-felt but unsolved need, and failure to others to attain the invention, may also be relevant to the obviousness determination. *Id.* at 17-18. When the "factual underpinnings" are in dispute, as in this action, the issue of obviousness is properly submitted to the jury. *E.g.*, *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993).

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[16] This finding alone mandates a verdict of non-infringement. The court does not address other methods by which the jury could have determined the non-infringement of claims 1, 2, and 7 of the '057 patent.

[17] *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993); *See also Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (referring to obviousness as a question of law based upon "several basic factual inquiries").

Here, the jury considered the differences between the prior art and the patent claim and concluded that the subject matter of the patent claim would have been obvious to a person of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103. The court reviews the jury's finding of obviousness to determine whether the factual findings implicit in the jury's verdict are supported by substantial evidence. *E.g., Jurgens v. McKasy*, 927 F.2d 1552, 1558 (Fed. Cir.), *cert. denied*, 112 S. Ct. 281 (1991) ("When the *Graham* factual underpinnings have been genuinely disputed . . . we presume that the jury resolved them in favor of th everdict winner."); *see also Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) ("Judges must accept the factual findings, presumed from a favorable jury verdict, wihch are supported under a substantial evidence/reasonable juror standard."), *cert. denied*, 493 U.S. 814 (1989)."

1. *Invalidity of Claim 1 of the '420 patent*

U.S. Surgical correctly asserts that in order for the jury to find that claim 1 of the '420 patent, a combination patent claim, was obvious, the jury had to find: (1) that the prior art would have taught or suggested, to the person of ordinary skill, the combination of individual elements found in the patented device, *e.g., Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 297 & n. 24 (Fed. Cir. 1985) (where party asserting invalidity relies on combination of prior art references, it must show teaching or suggestion in those references which support their use in combination), *cert. denied*, 475 U.S. 1017 (1986); and (2) that the prior art would sufficiently teach or direct one of ordinary

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[18] In reviewing the obviousness verdict, the court does not "lose sight of the presumption of [patent] validity," *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir. 1984), and takes into account the clear and convincing standard of proof required to prove obviousness. *Id.*

skill "how to obtain the desired result." *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990); *See Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724-25 (Fed. Cir. 1990). U.S. Surgical argues that Ethicon failed to adduce substantial evidence to support, by clear and convincing evidence, the jury's findings: (1) that the prior art taught or suggested the desirability of the U.S. Surgical invention; or (2) that the prior art would teach one of ordinary skill how to obtain the claimed invention. U.S. Surgical contends, as to these requirements, that Ethicon relied on only four pieces of prior art—the Green '226 patent, the Polk '239 patent, Yoon's 1987 abandoned patent application, and the Bonnet '965 patent—and that this prior art did not constitute substantial evidence.

Ethicon, in response, asserts that in order to prove obviousness, it relied on a large number of prior art references, particularly the large body of prior art concerning multiple clip appliers for conventional surgery and clip appliers. Ethicon argues that the only difference between the U.S. Surgical invention and the multiple clip appliers in the prior art was the invention's longer shaft and seal. These attributes, Ethicon argues, were obviously necessary for any endoscopic instrument, as demonstrated by the prior art in the endoscopic field. Further, Ethicon contends that it adduced substantial evidence in supoprt of the specific finding that the prior art taught or suggested the desirability of the claimed invention, *and* how to obtain it.

Evidence at trial established that the field of multiple clip appliers for conventional surgery was a highly developed and crowded field of art at the time of U.S. Surgical's invention. By 1989, numerous companies manufactured and sold approximately forty different multiple clip appliers for open surgery. Several of the multiple clip appliers in the prior art included many of the same general features of the U.S. Surgical invention, i.e., a

frame, a shaft, camming jaws, bias spring, pusher bar, and escapements.[19] Although this multiple clip applier prior art did not contain the mechanical qualities necessary for endoscopic instruments, the prior art also included a variety of endoscopic instruments, including endoscopic single clip appliers. Ethicon adduced evidence at trial that the only difference between the multiple clip applier prior art and the invention was that the invention was sealed and had a longer shaft. Ethicon argued that this difference made the invention obvious because the incorporation of a longer shaft and seal into the conventional multiple clip applier technology was obvious, considering the prior art in endoscopy. Ethicon's experts also testified that the prior art would have given a person of ordinary skill in the art a suggestion, incentive, or motivation to make the claimed invention.[20]

The jury concluded that, given the difference between the prior art and the invention, the invention would have been obvious to the person of ordinary skill in the field; that the prior art taught or suggested the combination of elements found in the invention;[21] and that the prior art also provided sufficient instruction how to obtain the invention.[22] These conclusions, the "factual underpinnings"

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[19] Prior art conventional clip appliers with these features included the Premium Surgiclip, disclosed in the Green '226 patent, and the Davis & Geck Multiclip, disclosed in the Montgomery '373 patent.

[20] *E.g.*, Transcript at 2238, 2332-33.

[21] U.S. Surgical "has not shown that reasonable jurors could not agree with [Ethicon's experts]" as to the prior art teaching the desirability of the invention. *See Bio-rad Laboratories v. Nicolet Instrument Corp.*, 739 F.2d 604, 611 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984).

[22] As to the requirement that the prior art provide a skilled person a "reasonable expectation of success" in obtaining the invention, the prior art evidence concerning multiple clip appliers and endoscopic instruments, and the testimony of inventors and experts concerning what that prior art taught as to how to build

of the determination of obviousness, are factual findings, *see Bio-rad Laboratories v. Nicolet Instrument Corp.*, 739 F.2d 604, 611 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984), which the court will not upset unless a reasonable jurior could not have so found. *Newell Cos.*, 864 F.2d at 765.[23] The court concludes that substantial evidence in the record supported the jury's factual findings in support of its verdict on obviousness. Accordingly, the motion for JNOV as to the obviousness of claim 1 of the '420 patent is denied. The court also denies U.S. Surgical's motion for a new trial on this issue.

2. *Invalidity of Claims 1, 2, and 7 of the '057 patent*

U.S. Surgical moves for JNOV, or, in the alternative, for a new trial as to the jury's conclusion that claims 1, 2, and 7 of the '057 patent, which were found not to be infringed by the EMCA/ERCA, were obvious. U.S. Surgical asserts that the jury's verdict as to these claims, i.e., noninfringement coupled with invalidity, is inconsistent, and a result that was not advocated by either party nor supported by sufficient evidence.[24]

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an endoscopic multiple clip applier, constitutes substantial evidence to support the jury's finding.

[23] In *Bio-rad Laboratories*, the court explained the role of the jury in determining obviousness: "This excerpt from [expert] testimony . . . illustrate[s] the importance of the jury's role in ascertaining the content of the prior art. The jurors must discern how a person of ordinary skill in the art would have interpreted available art at the time the invention was made. The factfinder's interpretation of prior art references is necessarily guided by the credibility given the testimony of experts." *Bio-rad Laboratories* 739 F.2d at 611.

[24] Ethicon's contention that U.S. Surgical waived its right to move for JNOV as to infringement of their patents by failing to move for a directed verdict at the close of the case lacks merit. On February 9, 1994, U.S. Surgical filed a written motion for

In *Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967 (1993), the Supreme Court recognized that the infringement and validity inquiries are independent:

> [O]ur prior cases have identified a strong public interest in the finality of judgments in patent litigation. . . [W]e approved of the District Court's decision to consider the question of validity even though it had found that a patent had not been infringed. . . . [W]e stated that "of the two questions, validity has the greater public importance, . . . and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

Id. at 1977 (citations omitted) (overruling Federal Circuit's practice of routinely vacating judgments of validity after finding noninfringement). Accordingly, in this case the court instructed the jury to determine patent validity even if it found noninfringement. The jury was not required to adopt entirely the position of one party or the other, or accept the entire testimony of a given expert. Upon motion for JNOV, "[w]here there is a view of the case that makes the juries answers to special interrogatories consistent, they must be resolved that way." *Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1563 (Fed. Cir.), *cert. denied*, 488 U.S. 850 (1988).[25] Here, the court concludes that the jury's conclusions as to infringement and validity can be harmonized with the evidence presented, and that substantial evidence in the record supports the court's conclusion of invalidity of claims 1, 2, and 7 of the '057 patent.

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judgment as a matter of law on the issues of infringement and validity.

[25] The Second Circuit has stated: "A district court has a duty to reconcile the jury's answers on a special verdict form with any reasonable theory consistent with the evidence, and to attempt to harmonize the answers if possible under a fair reading of those answers." *McGuire v. Russell Miller, Inc.*, 1 F.3d 1306, 1311 (2d Cir. 1993).

Accordingly, the motion for JNOV as to the validity of claims 1, 2 and 7 of the '057 patent is denied. The court also denies the motion for a new trial on this issue.

C. Motions for New Trial

1. *Interpretation of Claims by the Jury*

At trial, U.S. Surgical urged the court to instruct the jury on the meaning of the four patent claims at issue.[26] Ethicon, in response, argued that, because the parties intensely disputed the meaning of the claims and because the parties presented conflicting extrinsic evidence concerning the meaning of the claim, the court should submit the issue of claim interpretation to the jury to decide in its determination of infringement. The court instructed the jury to determine the meaning of the patent claims. U.S. Surgical now claims that the court's failure to instruct the jury on the meaning of each patent claim at issue constitutes error which requires a new trial.

U.S. Surgical asserts that the construction of patent claims is an issue of law, which the court may submit to the jury only where a "disputed issue of fact" arises in connection with the interpretation of a term in a claim. Notwithstanding the diametrically opposed testimony of the parties' mechanical experts and legal experts as to the meaning of the U.S. Surgical patent claims, U.S. Surgical contends that no factual dispute existed as to the meaning of the patent claims in this action.

The Federal Circuit, on numerous occasions, has stated that, "[c]laim interpretation is a question of law for the court." *Read v. Portec Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1922); *Associated Equipment Corp. v. Authorized Motor Parts Corp.*, 27 U.S.P.Q.2d 1784, 1785 (Fed. Cir. 1993); *Structural Rubber Prods. v. Park Rubber*

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[26] U.S. Surgical submitted to the court not less than 30 pages of proposed jury instructions concerning the meaning of the U.S. Surgical patent claims at issue.

Co., 749 F.2d 707, 721 (Fed. Cir. 1984). However, a similarly long line of Federal Circuit cases maintains that: "[W]hen the meaning of a term in the claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying fact question arises, and the construction of the claim should be left to the jury under appropriate instruction." *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985).[27] In *Tol-o-matic v. Proma Produkt-Und Marketing*, 945 F.2d 1546, 1550 (Fed. Cir. 1991), the Federal Circuit described the "underlying factual questions" that the jury should consider when the meaning of patent claim terms is unclear: "the description of the claimed element in the specification,

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[27] *See Associated Equipment*, 27 U.S.P.Q.2d at 1786 ("In a jury trial, it is the jury's province to find the facts. Thus, in cases where factual disputes underlie the ultimate legal question of claim interpretation, the issue of claim interpretation must be submitted to the jury for its decision once it finds the underlying facts."); *Drexelbrook Controls, Inc. v. Endress & Hauser, Inc.*, 1993 U.S. App. LEXIS 1915, at *4 (Fed. Cir. 1993) ("Although claim interpretation is a question of law, . . . where the claim terms in issue involve complex scientific principles and conflicting expert testimony, an underlying question of fact is created."); *Lemelson v. General Mills*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992) ("[T]he determination of the scope of the claim—its interpretation and proper construction—while denominated a question of law is in many cases based on the facts . . . . The underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement."), *cert. denied*, 113 S.Ct. 976 (1993); *Tol-o-matic v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991) ("When the meaning of a term in a patent claim is unclear, the jury may interpret the term en route to deciding the issue of infringement."); *Snellman v. Ricoh Co., Ltd.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988) (upholding the jury's apparent claim interpretation in view of expert testimony and the language of the specification), *cert. denied*, 491 U.S. 910 (1989); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.) ("[If] the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, the construction of claims could be left to a jury [and] the jury cannot be directed to the disputed meaning for the term . . . ."), *cert. denied*, 469 U.S. 1037 (1984).

the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." Here the court determined that a genuine dispute of fact existed as to these questions, and as to how one skilled in the art would construe the U.S. Surgical patent claims,[28] as demonstrated by conflicting expert testimony on the issue. Pursuant to Federal Circuit precedent, the court submitted claim construction to the jury for its determination "en route to deciding the issue of infringement." *Id.* at 1550. Accordingly, the court denies U.S. Surgical's motion for a new trial on this ground.[29]

2. *Exclusion of Evidence of Ethicon's Patents*

As grounds for a new trial on the issue of infringement, Ethicon contends that the court erred in excluding evidence concerning Ethicon's '247 and '249 patents, which the PTO granted to Ethicon for the ERCA and EMCA.[30] Ethicon asserts that its patents on the accused devices are powerful evidence of non-infringement,

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[28] Patent claims should be construed as one skilled in the art would construe the claims. *E.g., Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986).

[29] U.S. Surgical also contends that the court erred when it: (1) failed to instruct the jury as U.S. Surgical requested concerning (a) the absence of secondary considerations, (b) the significance of prior art references that teach away from the claimed invention, and (c) "equivalents" under 35 U.S.C. § 112; and (2) when it permitted certain evidence and did not instruct the jury as requested by U.S. Surgical concerning (a) the manner in which the invention was made; (b) the market effects of injunctive relief; (c) the significance of cumulative prior art references. The court concludes that these claims are without merit, and denies U.S. Surgical's motion for a new trial on these grounds.

[30] Prior to trial the court granted U.S. Surgical's motion in limine to exclude evidence and argument concerning Ethicon's patents on the accused devices. The court denied Ethicon's January 6, 1994, motion to reconsider the court's ruling. The court also

and that the court's evidentiary ruling constitutes prejudicial error. Further, in its argument for JNOV as to the infringement of claim 1 of the '420 patent, Ethicon asserts that "the issuance of Ethicon's '247 and '249 patents in and of itself requires a finding of non-infringement [as to] the 'clip closing means' " claim element.

In *Atlas Powder v. E.I. DuPont De Nemours,* 750 F.2d 1569 (Fed. Cir. 1984), the Federal Circuit established that the receipt of a patent on an accused device does not negate infringement:

> [W]here defendant has appropriated the material features of the patent in suit, infringement will be found "even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement." (quoting *Bendix Corp. v. United States,* 199 U.S.P.Q. 203 (Ct. Cl. Trail Div. 1978)). . . .
>
> . . . .
>
> "Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the conclusion. In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay any attention thereto. . . . Patentable difference does not of itself tend to negative infringement." (quoting *Herman v. Youngstown Car Mfg. Co.,* 191 F. 579, 584-85 (6th Cir. 1911)).

Id. at 1580-81.[31] *See also Chemical Eng. Corp. v. Essef*

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denied Ethicon's proposed jury instruction, which would have informed the jury of Ethicon's patents on the accused devices and instructed the jury as to how to consider the evidence.

[31] Ethicon argues that the Federal Circuit's ruling in *Atlas Powder* concerning the relevance of subsequent patents on the accused device does not apply in cases involving means-plus- func-

Indus., Inc., 795 F.2d 1565, 1569 & n. 6 (Fed. Cir. 1986) (patent on accused device "utterly irrelevant to infringement"); *King Instr. Corp. v. Otari Corp.*, 767 F.2d 853, 867 (Fed. Cir. 1985) (patent on accused device is "irrelevant in infringement analysis"), *cert. denied*, 475 U.S. 1016 (1986).

However, Ethicon asserts that the Federal Circuit's decision in *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948 (Fed. Cir. 1993), required the court to admit evidence of Ethicon's patents on its accused devices. In *Hoganas*, the Federal Circuit affirmed the court's summary judgment ruling of non-infringement of the plaintiff's patent claims, both literally and under the doctrine of equivalents. *After* concluding that the district court correctly granted summary judgment, the Federal Circuit stated:

> In support of our conclusion, we note that the PTO granted [the defendant] a patent [on the accused product] with the knowledge of the]plaintiff's[patent, which is listed as art of record. Thus, the PTO must have considered the accused product to be nonobvious with respect to the patented composition.

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tion claims, and that evidence of patents can be excluded only in cases concerning structure patent claims. However, courts have applied this rule of relevance to means-plus-function claims. *See, e.g., Texas Instruments*, 805 F.2d at 1563-64; *Pfaff v. Wells Electronics, Inc.*, 9 U.S.P.Q.2d 1366, 1368 (N.D. Ind. 1988); *Rite-Hite Corp. v. Kelley Co.*, 629 F. Supp. 1042, 1056 (E.D. Wis. 1986); *Bendix Corp. v. United States*, 199 U.S.P.Q. 203, 221-222, 224 (Ct. Cl. 1978). The court disagrees with Ethicon's assertion that the PTO's analysis—determining whether a given structure in Ethicon's device is patentable (novel and nonobvious) after considering the structures specified in U.S. Surgical's patents, which were prior art—is identical to the jury's infringement analysis of means-plus-function claims, i.e., determining whether the EMCA/ERCA's structures to perform a certain function are the substantial equivalent of the structures disclosed in the U.S. Surgical patents to perform a certain function. *See Atlas Powder*, 750 F.2d at 1581.

> Accordingly, the issuance of that patent is relevant to the equivalence issue.

Id. at 954. *Hoganas* established that patents on an accused device *can* be relevant to the infringement analysis. *Id. Hoganas* did not establish that such patents must always be admitted into evidence, and that failure to do so constitutes prejudicial error.[32] Here, the court excluded the evidence of Ethicon's '247 and '249 patents based not only on their limited relevance, but because the probative value of the evidence was substantially outweighed by the danger of unfair prejudice, confusion of the issues, and misleading the jury. Fed. R. Evid. 403. Because a jury could be easily misled by the evidence of Ethicon's patents, or fail to comprehend the proper limited role of such evidence in the infringement analysis, the Federal Circuit has affirmed the practice of excluding such evidence. *See Glaros v. H.H. Robertson Co.*, 230 U.S.P.Q. 393, 398 (Fed. Cir. 1986) (affirmed excluding patent on accused device because it "would have injected frolics and detours" and was "likely to create side issues that would have unduly distracted the jury from the main issues"); *see also Blanchard v. Putnam*, 75 U.S. 420, 425-26 (1869); *Union Carbide Corp. v. Tarancon Corp.*, 742 F. Supp. 1565, 1577 (N.D. Ga. 1990) ("most lay people believe that once they receive a patent, their invention has been held unique *and* non-infringing") (emphasis in original); *Crown Cork & Seal Co. v. Ethyl Corp.*, 11 U.S.P.Q.2d 1577, 1580 (E.D. Va. 1989); *Padco, Inc. v. Newell Cos. Inc.*, 13 U.S.P.Q.2d 1607, 1611, 1613 (E.D. Wis. 1989).

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[32] In *Hoganas*, the Federal Circuit reviewed the court's ruling granting summary judgment, not an evidentiary ruling in a jury trial concerning the admission into evidence of the defendant's patents. In contrast to a jury trial, it is unlikely that the court would attach improper legal significance to the defendant's patents, or that the court would be confused by such evidence.

Accordingly, the court denies Ethicon's motion for a new trial on this ground.[33]

3. *The Dictionary*

On the first day of the jury's three day deliberations, the jury requested a dictionary. Early in the second day of the deliberations, the court provided to the jury *Webster's New World Dictionary*. U.S. Surgical argues that it is entitled to a new trial because the court erred in providing a dictionary to the jury during its deliberations.

The court instructed the jury as to the legal definitions of important terms in this action such as "obviousness" and "infringement." Further, the court instructed the jury that the court's instructions on the law were to govern their deliberations, and that they were not to stray from the legal principles contained in the instructions. *See DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 425 (Fed. Cir. 1986) (the law presumes that the jury followed the court's instructions and found all facts necessary for the verdict). In its jury instructions concerning the interpretation of patent claims, the court also instructed the jury that it should consider, among other factors, "the ordinary meaning of the language used in the claim." Charge to the Jury, at 13. Because the jury was properly instructed to consider the "ordinary meaning" of the terms used in the patent claims, the court concludes that the court correctly provided the jury with a dictionary upon their request. *See State v. Asherman*, 193 Conn. 695 (1984) ("the definition of words in our standard dic-

[33] Ethicon also moves for a new trial on the grounds that the court erred in its instructions to the jury concerning the doctrine of equivalents. The court concludes that the motion lacks merit, and, therefore, denies the motion. Ethicon also moves for a trial on the issue of inequitable conduct, should the court grant U.S. Surgical's motion for JNOV, or order a new trial on any issue. Because the court has not so ordered, the motion is denied as moot.

tionaries is taken as a matter of common knowledge which the jury is supposed to possess"). Further, U.S. Surgical has not established that the provision of the dictionary resulted in prejudice. *Cf. United States v. Steele*, 785 F.2d 743, 748 (9th Cir. 1986) (irrelevant that dictionary definition of "infringement" may have differed from the legal definition set forth in the charge, absent evidence that the jury actually disregarded the court's instruction).

Accordingly, the court denies U.S. Surgical's motion for a new trial on this ground.

CONCLUSION

For the reasons contained herein, U.S. Surgical's motions for JNOV and for a new trial (documents no. 454 and 456) are denied, and Ethicon's motions for JNOV and for a new trial (document no. 459) are denied.

It is so ordered, this 7th day of June, 1994, at Hartford, Connecticut.

/s/ Alfred V. Covello
ALFRED V. COVELLO
United States District Judge

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

94-1386, -1419

UNITED STATES SURGICAL CORPORATION,
Plaintiff-Appellant,

v.

ETHICON, INC and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants/Cross-Appellants.

ORDER

A combined petition for rehearing and suggestion for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on March 30, 1995, unless another timely petition for rehearing is filed within the time permitted by Rule 40.

FOR THE COURT
FRANCIS X. GINDHART
Clerk

By /s/ Diane M. Frye
DIANE M. FRYE
Chief Deputy Clerk

Dated: March 23, 1995

APPENDIX D

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

592CV134 (WWE)
March 5, 1993

UNITED STATES SURGICAL CORPORATION,
Plaintiff,

v.

ETHICON, INC and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants.

RECOMMENDED RULING ON PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT ON THE ISSUE OF INFRINGEMENT OF CLAIM 1 OF U.S. PATENT NO. 5,100,420

Introduction

Plaintiff, United States Surgical Corporation ("USSC") has moved for summary judgment (Docket Entry No. 240) that the defendants', Ethicon, Inc., and Johnson & Johnson Hospital Services, Inc., (collectively "J&J") endoscopic multiple clip applier, known as the "EMCA", and a rotatable version thereof, known as the "ERCA", infringe claim 1 of U.S. Patent 5,100,420 (hereinafter the '420 Patent).

In support of its motion, plaintiff contends that there are no material facts in issue as to the scope of claim 1 and that the accused EMCA and ERCA devices fall within the metes and bounds theerof. Defendants vig-

orously dispute these assertions and contend that the interpretation of claim 1 raises certain underlying factual issues necessitating consideration of extrinsic evidence to resolve. Further, defendants contend that if claim 1 is interpreted not to literally read on the accused devices, there is a factual issue for the jury, as to whether the accused devices perform substantially the same function, in substantially the same way, to achieve substantially the same results, under the doctrine of equivalents used to determine infringement in patent cases.

For the reasons set forth below, a threshold factual issue underlying the interpretation of the scope of claim 1 of the '420 Patent exists which must be resolved with the aid of extrinsic evidence before infringement can be determined. Accordingly, USSC's Motion for Summary Judgment on the Issue of Infringement of Claim 1 of the '420 Patent will be denied.

The Underlying Factual Dispute

Claim 1 of the '420 Patent covers an endoscopic multiple clip applier used in combination with a trocar having a cannula, and a valve means for sealing the cannula. The means portions of the claim that are in dispute are the means for sequentially closing a plurality of surgical clips as they are applied to, for example, a blood vessel in the body, and the valve means between the trocar and cannula sealing the cannula to prevent the escape of gas from the body cavity in which the clip applier is inserted during the surgical procedure.

Claim 1 of the '420 Patent reads as follows:

> "1. In combination:
>
> a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity;
>
> b) an endoscopic clip applier having:

i) a frame;

ii) an endoscopic portion defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith, said endoscopic portion further including a plurality of surgical clips disposed in an array and *clip closing means for sequentially closing said surgical clips*; and

iii) *seal means* associated and *adapted to cooperate with at least one of said endoscopic portion and said frame* to obstruct passage of gaseous media from the body cavity." (emphasis added).

In its moving papers, USSC admits that a "dispute . . . exists between the parties . . . around the phrase 'clip closing means for sequentially closing the surgical clips' contained in Section b) ii)." (USSC Memorandum of Points and Authorities, p. 2).

The invention as defined by claim 1 relates to a device for applying surgical clips in endoscopic procedures. Endoscopic surgery is performed through narrow tubes inserted through small entrance wounds in the skin. Endoscopic procedures generally require that any instrumentation inserted into the body be sealed, i.e., provisions must be made to ensure that gases do not enter or exit the body through the endoscopic incision as, for example, in surgical procedures in which the patient is insufflated. The clip applying apparatus includes the mechanism for introducing the clip through the sealed tube of the device into the body and a pair of jaws adapted to move distally relative to the apparatus to squeeze the clip closed about a blood vessel.

A trocar (claim element at 1 a) is an instrument that comprises a cutting tip, cannula or tube, and valve means for sealing the tube. The tube or cannula is in-

serted through the incision wound made by the cutting tip of the trocar into the body and an endoscopic multiple clip applier as defined in claim element 1 b) is then inserted through the cannula or tube into the body cavity.

USSC contends that the clip closing means as set forth in claim 1 should be given a definition as encompassed within the '420 specification as appearing at column 4, lines 23-25, as "comprising a pair of flexible opposing jaws which are cammed together into closure by a distally-moving channel . . ." for sequentially closing the clips. On the other hand, J&J contends that in order for the clip closing means to *sequentially* close a plurality of surgical clips, such means necessarily includes the mechanism that advances the clips for sequential closure, the escapement mechanism that limits sequential feeding to one clip at a time, as well as the jaws and cam channel used to form and close the clips. J&J contends that these structures are all necessary to the seqential clip closure (See Mann Affidavit, para. 5).

J&J further contends that the process of the '420 Patent discloses a semi-automatic mechanism for sequentially closing the clips. When one clip is in the jaws of the instrument, the surgeon can close that clip by squeezing the instrument's handle, but releasing the handle does not cause the next clip to automatically advance to sequential closure. In order to position the next clip for sequential closure, the surgeon has to press a separate release button, which releases a locking mechanism, which in turn allows the instrument's pusher bar to move forward and advance the next clip. J&J contends that the semi-automatic mechanism in the '420 Patent is a consequence of the structure disclosed in the '420 specification, particularly, J&J points to Figure 34A of the '420 Patent which shows the dimensional relationship between the jaws in their open position and the interior diameter of the trocar cannula. The Figure shows that the jaws

in their open position are substantially wider than the interior diameter of the trocar cannula. J&J concludes that the design of the '420 device resulted in this jaw structure because USSC was of the view that wide jaws were needed to provide the requisite force to close the clips. However, having jaws that are wider than the interior diameter of a cannula means that the jaws will partially close whenever the instrument is inserted into, or taken out of, a cannula. If that happened while a clip was in the jaws, there is a danger that the partially deformed clip would drop out of the jaws and into the body cavity. Thus, in order to prevent this, USSC designed a locking mechanism giving rise to the semi-automatic operation of the device. The locking mechanism prevents the next clip from advancing automatically into the jaws for sequential closure *until the surgeon presses a separate release button,* as specified at column 14, lines 56-60. This permits the instrument to be inserted into or removed from a cannula without a clip in the jaws, but J&J contends that this necessarily means that the device cannot automatically advance clips for sequential closure.

In contrast, the J&J accused devices have an automatic mechanism for sequentially closing a plurality of surgical clips. The clips are advanced automatically into the jaws without a separate safety or release mechanism because the jaw structure utilized by defendants is allegedly substantially different from the jaw structure disclosed in the '420 Patent. The jaws in their open position are narrower than the interior diameter of the cannula into which the instrument is inserted. Because of the narrow jaws, the accused devices can pass through a cannula with a clip in the jaws without deforming the clip in the jaws and therefore without any danger of dropping the clip. (See Mann Affidavit, para. 6-14 inclusive).

Thus, J&J urges an interpretation of Claim 1 which requires clip closing means for sequentially closing the

clips which relies on a separate mechanism for releasing the clips to the jaws one at a time under positive action and control of the surgeon.

J&J also contends that facts and issues also exist as to the interpretation of "seal means" specified in Claim 1 of the '420 Patent. J&J contends that the sealing means disclosed in the '420 Patent are not identical to those in the accused devices and would not be covered by the sealing means recited in Claim 1. In the '420 Patent, a seal is provided by "close tolerances with the internal moving parts" (Column 4, lines 68 *et seq.*). The structure disclosed for providing those tolerances consists of a "sealing block" formed from two U-shaped pieces that are joined together leaving an "axially extending" opening through which the pusher bar and cam channel can be disposed. (Column 5, lines 4-16). The surfaces of the sealing block are shown in close continuity with the cam channel and pusher bar. A layer of grease can be employed to fill the spaces between the parts in the inner surfaces of the sealing block.

It is argued that in contrast, the accused devices do not use a solid sealing block as disclosed in the '420 Patent, but J&J's devices employ a hollow compartment with five separate but adjacent chambers. There are narrow walls separating these hollow chambers and sealing occurs at the openings in the narrow walls between each of the chambers. Grease is inserted into the central chamber and is drawn into the narrow openings in the walls of the multiple chambers by movement of the cam channel and feed bar. It is contended that the sealing mechanism in the accused devices is different than in the '420 Patent in that the series of narrow walls and hollow chambers in the accused devices provides what is called a "labyrinth seal" and that the sealing pressure drop is spread over five separate, narrow surfaces; whereas, in the patented device the total pressure drop must take place along the single sealing block in order for the seal to function.

USSC vigorously opposes the contention that there are genuine facts in dispute. Further, USSC argues that the means for sealing the accused devices is based on the same close tolerances between the parts as disclosed and utilized in the '420 Patent structure.

The Applicable Legal Standards Governing Disposition of the Motion

Before discussing why summary judgment is inappropriate at this stage of the proceedings, a caveat would appear to be in order. There is no question that a claimed "means" for performing a particular function is not limited to the particular embodiments set forth in the specification. The patentee is only required to disclose a particular empodiment in the specification as a means for accomplishing the function set forth in the patent claim. There is certainly no requirement that a patentee describe or predict every potential means of accomplishing the function set forth in the claim. *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985). Otherwise, 35 U.S.C. § 112(b)(6) would have no meaning. To hold otherwise would be to nullify the provision of the statute requiring that means-plus-function limitations be construed to cover the structure described in the specification *and equivalents thereof. Pennwalt Corp. v. Durand- Wayland, Inc.*, 833 F.2d 931, 934 (Fed.Cir. 1987). Therefore, it is entirely possible that while the clip closing means for sequentially closing the clips and the sealing means of claim 1 may not be the same as in J&J's devices, they nevertheless may be considered equivalent when applying the test enunciated in *Valmont Industries, Inc. v. Rinke Manufacturing Co., Inc.*, Case. No. 91-1377, 1378 (Fed.Cir. 1993). An equivalent results from a use of an insubstantial change which adds nothing of significance to the structure or acts disclosed in the patent specification.

However, where, as here, there is some element of doubt as to the true scope of the claims in light of the

prior art and expert testimony concerning what one of ordinary skill in the art would have known at the time the invention was made,, the Court should reserve judgment as to the scope and interpretation of the claims until all of the evidence is in. *See: Palumbo v. Don-Joy Co.*, 762 F.2d 969, 973 (Fed. Cir. 1985).

As stated in *Palumbo* at 975 (Fed. Cir. 1985):

> "[An] infringement inquiry is broken down into two steps: first, the scope of the claims must be ascertained, and then the trier must decide whether the claims cover the accused device. The latter step, which is the ultimate determination of infringement is a fact issue. . .
>
> "Construction of a claim, *a question of law,* is necessary to define the metes and bounds of the protection afforded by the claims. If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law . . . but when the meaning of a term is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises and construction of the claim should be left to the trier or the jury under appropriate instruction."

Thus, both steps in the two-part inquiry to infringement may present factual matters not appropriately resolved in a motion for summary judgment. *Union Carbide v. Tarant Corp.*, 682 F.Supp. 535.

This principal has been endorsed by the Court of Appeals for the Federal Circuit. *Howes v. Medical Component, Inc.*, 814 F.2d 638; *Tillotsin Limited v. Walboro Corp.*, 945 F.2d 1549, holding that if expert testimony is needed to explain a disputed term or expert evidence will be helpful in determining the thrust and meaning of the prosecution histories and prior art, though claim interpretation is a question of law, there is no prohibition on the Court's obtaining potentially useful aid in under-

standing and determining these underlying factual questions. Summary judgment, under such circumstances, would be improper.

Claim interpretation is a function for the Court, not the jury. In a jury case, the Court must instruct the jury on the scope and meaning of the claim. The jury's sole role is to determine whether the invention, as defined by the Court, has been made and sold by the defendants. *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992). The Court, however, welcomes expert extrinsic evidence in order to aid it in its interpretation of the claim. Then, the Court will formulate appropriate instructions for the jury on the meaning of the claim and the jury will be the ultimate trier of fact as to whether the claimed elements, as interpreted by the Court, are found in the accused's devices. This may also include a determination, if the jury finds no literal infringement, of whether the invention in the accused's device infringes under the doctrine of equivalents. This determination is strictly within the providence of the jury and is a question of fact. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

Conclusion

Based on the foregoing anaylsis, there is still a substantial question concerning the scope of claim 1. Therefore, USSC's motion for summary judgment (Docket Entry No. 240) is DENIED.

Date: March 5, 1993

/s/ Barry Kramer
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APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

91-1393, -1394, -1409

PALL CORPORATION,
Plaintiff/Cross-Appellant,

v.

MICRON SEPARATIONS, INC.,
Defendant-Appellant.

92-1049

HERBERT MARKMAN and POSITEK, INC.,
Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC., and
ALTHON ENTERPRISES, INC.,
Defendants-Appellees.

ORDER

On further consideration of the appeals now pending before the court in banc, and because the above appeals raise significant issues related to interpretation of a claim in a patent, it is

ORDERED that additional briefing by the parties and by amici curiae may be filed as follows:

The briefs for appellants on rehearing in banc shall be filed on or before February 14, 1994. The briefs for appellees on rehearing in banc shall be filed on or before March 14, 1994.

The court is particularly interested in briefing on:

(1) Are disputes over the meaning of a term in a claim (a) issues of law to be decided on a documentary record, similar to questions of statutory construction, or (b) are there some claim construction disputes that can only be resolved by resort to extrinsic evidence which requires the taking of factual and expert testimony?

(2) If factual or expert testimony is proffered to resolve a particular dispute, what are the respective roles of the trial judge and jury?

(3) When a claim construction dispute is on appeal to this court, what is the standard of review this court should apply to the judgment below on the merits? With regard to permissible post-trial motions?

(4) When the meaning of a claim term must be decided in the course of deciding the question of infringement, what are the respective roles of trial judge and jury?

Amicus curiae briefs on rehearing in banc may be filed in accordance with Rule 29.

Oral argument will be scheduled after the briefs have been filed.

Briefs shall be filed in 30 copies.

FOR THE COURT

/s/ Francis X. Gindhart
FRANCIS X. GINDHART
Clerk

[Filed Jan. 7, 1994]

APPENDIX F

SUMMARY OF ARGUMENT, U.S. SURGICAL'S OPENING BRIEF FEDERAL CIRCUIT (Aug. 18, 1994)

III. SUMMARY OF ARGUMENT

U.S. Surgical seeks relief from a verdict that resulted from a trial in which the District Court disregarded this Court's repeated admonitions as to the proper role of a judge and a jury in a patent case. As is clear, the trial of a patent case should be very different from the trial of a common law negligence case. The goal in a patent case is to implement the national patent law. Its fair enforcement is not permitted to fluctuate with the idiosyncratic community sense of any one jury. *Strutctural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 723, 223 USPQ 1264, 1276 (Fed. Cir. 1984). It is therefore of paramount importance that the jury be properly informed of its fact-finding role, and that only disputed issues of fact be submitted to it. *Id.* at 713-14, 720-21, 722, 223 USPQ at 1268-69, 1274, 1275. This means that the trial court must perform its role of properly instructing the jury on the meaning of patent claims. It means that the trial court must instruct the jury on the material provisions of 35 U.S.C. § 103. It also means that the trial court must strongly dispel the plea of an infringer that it be allowed, in the name of competition, to continue to sell its product.

Contrary to these established norms for trying a patent case, the District Court did not define the meaning of the patent terms. It did not reasonably instruct on "obviousness." It took no action to overcome improper, inflammatory, and prejudicial argument from Ethicon. The Court invited the jury to function as the proverbial "black box into which patents are thrown [to] emerge intact or invalid by an unknown or unknowable process." *Id.* at 718 & n. 7, 223 USPQ at 1272 & n. 7.

The unguided jury, on its first day of deliberation, requested a dictionary. Rather than inform and guide the jury through proper instruction as this Court has admonished, *see, e.g., Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 n. 3, 23 USPQ2d 1426, 1432 n. 3 (Fed. Cir. 1992); *Genentech Inc. v. Wellcome Found. Ltd.*, —— F.3d ——, 31 USPQ2d 1161, 1165 & n. 6, 1172 n. 47 (Fed. Cir. 1994), the District Court highlighted and compounded its unwillingness to define the patent terms by providing the jury with *Webster's New World Dictionary* over the objection of both parties.

As in most patent cases, the material underlying facts were generally not in dispute. Here, the identity and content of the prior art was clear. The patent claims were clear, and not obfuscable. The material facts established non-obviousness, and '057 as well as '420 infringement. This appeal, therefore, seeks reversal and a remand for prompt entry of an injunction in favor of U.S. Surgical, as well as a trial on damages; or, in the alternative, in vindication of its right to an informed decision, *Structural Rubber*, 749 F.2d at 713, 223 USPQ at 1268, U.S. Surgical requests a remand for a new trial. *Genentech*, —— F.3d ——, 31 USPQ2d at 1172 n. 47.

APPENDIX G

FEDERAL CIRCUIT RULE 36

Rule 36. Entry of Judgment

Judgment of affirmance without opinion. The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following circumstances exist:

(a) the judgment, decision or order of the trial court appealed from is based on findings that are not clearly erroneous;

(b) the evidence in support of a jury verdict is sufficient;

(c) summary judgment, directed verdict, or judgment on the pleadings is supported by the record;

(d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or

(e) a judgment or decision has been entered without an error of law;

and an opinion would have no precedential value.

No. 94-2081

Supreme Court, U.S.
F I L E D
JUN 20 1995
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

UNITED STATES SURGICAL CORPORATION,

Petitioner,

—v.—

ETHICON, INC. and JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,

Respondents.

ON A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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No. 94-2081

IN THE

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OCTOBER TERM 1994

UNITED STATES SURGICAL CORPORATION,

Petitioner,

v.

ETHICON, INC. and JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,

Respondents.

ON A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondents Ethicon, Inc. and Johnson & Johnson Hospital Services, Inc. (collectively, "Ethicon") submit this brief in opposition to U.S. Surgical's Petition for a Writ of Certiorari.

STATEMENT OF THE CASE

The summary affirmance in this case did not announce a new or important or aberrant rule of law. It does not conflict with decisions of any other circuit court of appeals or the highest court of any state. It cannot be cited or followed

in any other case. It does not have any consequences beyond its effect on these parties. In short, there is nothing about it that it merits this Court's review.

U.S. Surgical seems to recognize this. Its petition tries to bootstrap this case to a different and unrelated case, which it believes is more worthy of certiorari than this one. But regardless of whether certiorari ought to be granted in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), there is no reason to grant it here.

As part of its bootstrap argument, U.S. Surgical tries to portray this case and *Markman* as raising the same issue. But the issue in *Markman* -- whether construction of patent claims is a fact issue for the jury or an issue of law for the court -- is not fairly presented by the facts of this case, and it had no impact on the outcome here.

U.S. Surgical's petition never addresses the impact, if any, that the issue presented by *Markman* had on the outcome of this case. Its petition studiously ignores the claim construction that U.S. Surgical advocated at trial. It also ignores the interplay between U.S. Surgical's claim construction and obviousness. These omissions are telling. When one addresses these issues instead of ignoring them, it is clear that the issue of who construes the claims had nothing to do with the result here.

At trial, U.S. Surgical asked for the broadest claim construction possible. It did this in order to maximize its chances of proving infringement. But U.S. Surgical's broad construction was a two-edged sword; it was also the construction most likely to lead to a finding that its patents were invalid for obviousness. Even without an instruction directing it to U.S. Surgical's broad construction of the claims, the jury found at the end of a four-week trial that U.S.

Surgical's claimed invention would have been obvious to a person of ordinary skill in the art. This finding would only have been all the more inevitable if the trial judge had directed the jury to U.S. Surgical's broad construction of the claims.

1. Background

The patents at issue in this case covered a surgical instrument known as an "endoscopic multiple clip applier. "

Endoscopic surgery is performed without major incisions, by inserting long, sealed instruments through narrow tubes or "cannulas" into a body cavity that has been inflated with carbon dioxide gas. The prior art included endoscopic versions of many surgical instruments, such as graspers, forceps, and scissors. Of necessity, the endoscopic versions of these instruments were always long and sealed.

Clip appliers are used in surgery to "ligate," or tie off, blood vessels and other anatomical structures. *Multiple* clip appliers can deliver one clip after another without reloading, the way an ordinary office stapler can deliver one staple after another. Multiple clip appliers have been used in surgery for many years, and were well-known in the prior art.

2. U.S. Surgical's Claim Construction

U.S. Surgical's claims could be construed in two ways. They could be read narrowly, as covering the particular instrument that U.S. Surgical developed and disclosed in its patents. Or they could be read broadly, as covering *any* endoscopic multiple clip applier with standard generic features for such an instrument. The narrower reading would not cover Ethicon's markedly different device. So U.S. Surgical made a tactical decision to try to preempt the entire field by advocating the broadest possible construction of the claims.

As U.S. Surgical construed the claims, its invention combined two well-known ideas from the prior art. The invention, as U.S. Surgical construed the claims, was simply an ordinary, generic multiple clip applier that was modified for endoscopic surgery by adding two features -- a long shaft and a seal.

U.S. Surgical's own experts admitted this. Thus, U.S. Surgical's expert on patent law testified that ordinary prior art clip appliers would "constitute" the claimed invention if they merely were "sealed and had a long shaft." (A 455; Tr. 1533-35). U.S. Surgical's technical expert agreed. (A 386; Tr. 1157). Thus, U.S. Surgical's experts conceded that a long shaft and a seal were the *only* points of difference between ordinary multiple clip appliers and the claimed invention.

3. The Interplay Between U.S. Surgical's Claim Construction And Obviousness

This concession had devastating implications for U.S. Surgical on the issue of obviousness. That was because a long shaft and a seal were well-known, obvious requirements for *any* endoscopic instrument.

The instruments used to perform endoscopic surgery need to be -- and always have been -- long (in order to reach a relatively distant operative site) and sealed (so that gas does not escape from a body cavity that has been inflated with carbon dioxide). U.S. Surgical admitted this right in the text of its patents, when it stated that endoscopic instruments "must be sealed so as to prevent gas leakage . . . [and] sufficiently long to reach the desired organs or tissue." (A 143, 169). This was well known for decades.

Because endoscopic instruments have always been long and sealed, U.S. Surgical's broad claim construction

turned the inquiry on obviousness into a question that answered itself: whether a person of ordinary skill in the art who wanted to adapt a multiple clip applier for endoscopic surgery would have found it obvious to include two standard features of all endoscopic instruments, *i.e.*, a long shaft and a seal.

4. Testimony Of U.S. Surgical's Experts On Obviousness

U.S. Surgical's broad claim construction put its experts in an untenable position when Ethicon raised the defense of obviousness. Saddled with that broad construction, U.S. Surgical's technical expert chose to deny something that was apparent to everyone in the courtroom: that it would have been obvious for an endoscopic instrument to have a long shaft and a seal. Thus, the expert testified as follows:

> Q: We have [an ordinary prior art multiple clip applier] . . . and somebody comes to you and says, gee, can we make the device endoscopic? You are saying it's not obvious to make the device long, cylindrical and sealed?
>
> A: [That's] exactly what I'm saying.

A 647 (Tr. 2585).

The denial by U.S. Surgical's expert that an endoscopic instrument obviously should be long and sealed ran counter to all the evidence. It was completely incredible. Endoscopic instruments, of necessity, were *always* long and sealed. That was not in dispute. The jury could see this for itself, simply by looking at the large collection of prior art endoscopic instruments -- all of them long and sealed -- on display in the courtroom. U.S. Surgical's expert, however, chose to give this

incredible testimony because his only alternative was to concede the obviousness of the invention under U.S. Surgical's broad construction of the claims.

5. The Trial Court's Instructions

In its proposed jury instructions, U.S. Surgical asked the district judge to place his imprimatur on its broad construction of the claimed invention as a long, sealed version of a generic multiple clip applier. The judge refused to do so because the underlying facts were sharply disputed. Following then-controlling Federal Circuit precedent,[1] the district judge instead submitted claim construction to the jury, along with the issues of infringement and obviousness. The judge gave the jury extensive, accurate instructions on all of these issues, including careful and correct instructions on how the jury should go about construing the claims.

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[1] *See, e.g., Delta-X Corp v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989); *Snellman v. Ricoh Co., Ltd.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

6. The Jury's Verdict, And The Denial Of U.S. Surgical's Motion For JMOL

After four days of deliberations, the jury returned a verdict. It found, *inter alia*, that all four of the claims on which U.S. Surgical sued would have been obvious to a person of ordinary skill in the art.

After the verdict, the U.S. Surgical moved for JMOL. Its principal argument was that, as a matter of law, the claimed invention would not have been obvious to a person of ordinary skill. The district court denied this motion. It found, *inter alia*, that the obviousness verdict was supported by substantial evidence, including evidence that the only points of difference between the invention and a generic multiple clip applier -- a long shaft and a seal -- were well-known, obvious features for *any* endoscopic instrument. Pet. at 20a-22a.

7. U.S. Surgical's Appeal

U.S. Surgical now tries to create the impression that its appeal in the Federal Circuit centered on the issue of whether the trial court erred in denying its request for an instruction construing the claims. That was not the case.

The question of who construes the claims, judge or jury, was a minor tangent in U.S. Surgical's appeal brief.[2] It was relegated to just a single paragraph in the "Argument" section of that brief, appearing *after* U.S. Surgical's main argument that the claimed invention was "Not Obvious As A Matter of Law" (App. A at A-1-6), and *after* its additional argument that a new trial was necessary because of alleged

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[2] The Argument section of U.S. Surgical's appeal brief is reproduced in full as Exhibit A hereto.

errors in the trial court's instructions on obviousness (*id.*, at A-6-9).

It is not surprising that U.S. Surgical stressed other points while de-emphasizing the issue of who construes the claims. After all, U.S. Surgical could not point to *any* prejudice from the denial of its request for an instruction directing the jury to the claim construction most likely to lead to a finding of obviousness.

When Ethicon pointed this out in its opposition brief on appeal, U.S. Surgical had no response. It was never able to articulate any way in which it was prejudiced by the denial of its proposed instruction construing the claims.

Upon consideration of U.S. Surgical's arguments, the Federal Circuit affirmed the judgment without opinion.

8. U.S. Surgical's Request That The Federal Circuit Rehear This Case *En Banc* Or, In The Alternative, Defer Decision Pending *Markman*

After the Federal Circuit's summary affirmance, U.S. Surgical grasped at the *Markman* straw. It did this in a Petition For Rehearing, With A Suggestion For Rehearing En Banc, which asked the panel, and the entire court sitting *en banc*, to re-hear this case because of two issues that were buried at the back end of its appeal brief: (a) a claim that U.S. Surgical was prejudiced by the trial court's submission of a standard dictionary to the jury; and (b) the issue of who construes the claims, which was then pending before the Federal Circuit *en banc* in *Markman*.

In the alternative, U.S. Surgical asked the Federal Circuit to "hold this case [in abeyance] until its issuance of an

opinion *en banc* in . . . *Markman*." (Suggestion For Rehearing En Banc at 14). Once again, U.S. Surgical could not identify any prejudice caused by the denial of its proposed instruction construing the claims.

U.S. Surgical's Petition for Rehearing and its Suggestion of Rehearing En Banc were summarily denied.

9. U.S. Surgical's Conspiracy Theory

To explain the result in the Federal Circuit, U.S. Surgical now conjures up a conspiracy involving two judges on the Federal Circuit. U.S. Surgical imagines that it lost on appeal because Judge Newman and Judge Rader were secretly determined "not to bow to their colleagues" who joined in the *Markman* majority (Pet. at 8), and decided instead to "impose their idiosyncratic views in a summary affirmance." (*Id.*, at 15-16).

This conspiracy theory is irresponsible and absurd. Judge Newman and Judge Rader have gone on record in expressing their reservations about the outcome in *Markman*. But the *Markman* issue had nothing to do with the outcome of this case, and was only a minor tangent in U.S. Surgical's appeal. The main themes in U.S. Surgical's appeal brief involved issues unrelated to *Markman*, including the sufficiency of the evidence of obviousness and alleged errors in the instructions on obviousness. *See* App. A at A-1-9.

Moreover, U.S. Surgical's Suggestion For Re-Hearing En Banc, which raised the *Markman* issue, was circulated to each of the eleven Federal Circuit judges in regular active service -- including the eight judges who joined in the

Markman majority.[3] It is telling that *not one* of the Federal Circuit's eleven judges was in favor of U.S. Surgical's suggestion for *en banc* re-hearing, and *not one* judge on the entire court was in favor of deferring this case pending a decision in *Markman*.

These facts refute U.S. Surgical's conspiracy theory. For good reason, all eleven of the Federal Circuit's active judges -- and not just Judge Newman and Judge Rader -- rejected U.S. Surgical's request to hold this case in abeyance until *Markman* was decided. If there was a conspiracy on the Federal Circuit to subvert the *Markman* decision, as U.S. Surgical imagines, it thus would seem to include not only Judge Newman and Judge Rader, but also Chief Judge Archer (who wrote the majority opinion in *Markman)*, each of the seven judges who joined in Chief Judge Archer's majority opinion, and Judge Mayer (who concurred in the result).

REASONS WHY THE WRIT SHOULD BE DENIED

I. This Case Does Not Present The Issue Presented By *Markman*

This Court should reject U.S. Surgical's attempt to bootstrap its petition to the petition for certiorari in *Markman v. Westview Instruments*. The issue presented by *Markman*, of whether claim construction is a fact issue for the jury or an issue of law for the judge, had no impact on this case. For

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[3] Rule 35, Fed. R. App., and Federal Circuit Rule 35 both require that a suggestion for rehearing *en banc* must be circulated not only to the members of the panel, but also to all judges on the court who are in regular, active service.

good reason, it was only a minor point in U.S. Surgical's appeal. That issue is not fairly presented by this case. Whether or not this Court grants certiorari in *Markman*, there is no reason to grant it here.

At trial, U.S. Surgical advocated the broadest claim construction possible, because a narrower construction would not have covered the Ethicon device. But as demonstrated above at pages 3-6, U.S. Surgical's broad construction of the claims virtually compelled a finding of obviousness. If anything, an instruction that directed the jury to U.S. Surgical's broad construction would have made the obviousness verdict all the more inevitable.

On appeal, U.S. Surgical's brief treated the issue of who construes the claims as a subsidiary point. That made perfect sense because U.S. Surgical could not identify any prejudice from the denial of an instruction directing the jury to its broad construction of the claims. The issue does not deserve more serious treatment now.

As part of its effort to bootstrap this case to *Markman*, U.S. Surgical argues that the record in this case would illuminate the issues in *Markman*. It suggests, for example, that its "comprehensive [proposed] instructions" interpreting the claims would provide this Court with an "invaluable aid" in deciding the issue presented by *Markman*. (Pet. at 13-14).

The record in *Markman*, however, presents that issue perfectly well on its own. That is why the Federal Circuit selected *Markman*, and not this case, as a vehicle for *en banc* consideration of the issue. The issues in *Markman* do not need to be illuminated by the record in this case.

Moreover, U.S. Surgical's "comprehensive instructions" were infected with basic errors of substantive

law. Among other things, U.S. Surgical's proposed instructions were inconsistent with settled law on how to construe "means-plus-function" elements under 35 U.S.C. §112(6).[4] Erroneous instructions would not aid in deciding *Markman* if certiorari is granted in that case.

II. There Is No Reason For This Court To Hold This Case In Abeyance Pending Action In *Markman*, Or To Supervise The Decision By The Eleven Active Judges On The Federal Circuit Not To Hold This Case In Abeyance Pending *Markman*

U.S. Surgical also asks this Court to hold this case in abeyance pending further action in *Markman*. Earlier, when the Federal Circuit was on the verge of issuing its *en banc* decision in *Markman*, U.S. Surgical made a similar request to the eleven active judges on the Federal Circuit. This Court should be guided by their unanimous response.

Not one of the Federal Circuit's eleven active judges voted to rehear this case in light of *Markman*. Moreover, *not one* of those eleven judges was in favor of deferring this action pending the soon-to-be-issued decision in *Markman*.

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[4] For example, U.S. Surgical's construction of means-plus-function elements erroneously disregarded the structure for performing particular functions, as described in the portion of the patent specification that discusses the preferred embodiments of the invention. That approach was error. *King Instruments Corp. v. Otari Corp.*, 767 F.2d 853, 862 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986).

The denial of U.S. Surgical's request to hold this case in abeyance pending *Markman* was sound and sensible. As the Federal Circuit's eleven judges recognized, implicitly if not explicitly, the soon-to-be issued opinion in *Markman* would not in any way affect the result here. Indeed, the instruction that U.S. Surgical requested, directing the jury to its broad construction of the claims, would only have made the finding of obviousness all the more likely. *See*, pages 3 to 6, *supra*.

The timing of the Federal Circuit's refusal to defer a decision in this case pending *Markman* makes its views on that issue especially significant. *Markman* had been *sub judice* for more than ten months, but a decision in *Markman* was less than two weeks away at the time the Federal Circuit's eleven active judges denied U.S. Surgical's request to defer this case pending a decision in *Markman*. There is no greater reason to hold this case in abeyance now.

If this Court were to grant certiorari in *Markman* and review that case on the merits, there could be two possible outcomes. One possible outcome is that this Court might agree with the Federal Circuit's decision in *Markman*, and conclude that claim construction is invariably a question of law. But as eleven Federal Circuit judges have already implicitly recognized, this holding would not affect the result in this case -- because U.S. Surgical was not prejudiced in the slightest by the denial of a jury instruction construing the claims in the way most likely to lead to a finding of obviousness.

A second possible outcome if this Court grants certiorari in *Markman* is that this Court might agree with the *Markman* dissent, and conclude that claim construction may be submitted to the jury where it depends on facts that are genuinely in dispute. This outcome would also have no effect

on this case, because the trial court followed that approach here.

Either way, a decision on the merits in *Markman* would not affect the finding of obviousness in this case. In these circumstances, the Federal Circuit's decision not to defer this case pending *Markman* was appropriate in all respects. It presents no occasion for this Court's review.

III. The Federal Circuit's Decision Does Not Conflict With Precedent From Other Circuits On The Dictionary Issue

U.S. Surgical also asks this Court to grant certiorari to resolve a purported conflict on whether the trial court's submission of a standard dictionary to the jury requires a new trial. However, the Federal Circuit's summary affirmance is in harmony with the views of virtually every court that has considered this issue. As one court has stated:

> It appears to be the near universal consensus that a new trial is not awarded simply because a dictionary was before the jury.

Wernsing v. General Motors Corp., 470 A.2d 802, 806 (Md. 1984). This "near universal consensus," *id.*, is grounded in clear logic and common sense. "[T]he definition of words in our standard dictionaries is . . . a matter of common knowledge which the jury is supposed to possess." *State v. Asherman*, 193 Conn. 695, 478 A.2d 227, 252 (1984), *cert. denied*, 470 U.S. 1050 (1985). For this reason, the overwhelming majority of

courts have found nothing about the jury's exposure to a dictionary that requires a new trial.[5]

U.S. Surgical also purports to identify a conflict between the Federal Circuit's summary affirmance and *United States v. Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985), on the issue of whether the trial court should have been required to hold a hearing to determine how the jury used the dictionary. This argument misreads *Weiss*, and overlooks Rule 606(b), Fed. R. Evid., which precludes such a hearing.

In *Weiss*, jurors obtained access to *extraneous* material without the trial judge's approval. That was not the case here. Rather than being "extraneous," the dictionary was submitted to the jury in this case upon the direction of the trial judge. It was not "extraneous" in any meaningful sense. Rather, it was akin to evidence that the trial court admits over an objection or adduces on its own, when it calls and questions a witness not called by either side, as permitted by Rule 614, Fed. R. Evid.

Neither *Weiss* nor any other case applying the Federal Rules of Evidence permits a hearing on how jurors used

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[5] *See, e.g., United States v. Turner*, 936 F.2d 221, 226 (6th Cir. 1991); *United States v. Cheyenne*, 855 F.2d 566, 568 (8th Cir. 1988); *United States v. Steele*, 785 F.2d 743, 746 (9th Cir. 1986); *Copeland v. Gulf Oil Corp.*, 672 F.2d 867, 871-72 (11th Cir. 1982); *United States v. Duncan*, 598 F.2d 839, 866 (4th Cir.), *cert. denied*, 444 U.S. 871 (1979); *United States v. Gunter*, 546 F.2d 861, 869 (10th Cir.), *cert. denied*, 431 U.S. 920 (1977). *See also*, *Wernsing*, 470 A.2d at 806 (collecting cases).

material submitted to them on the trial judge's direction. [6] Indeed, Rule 606(b), Fed. R. Evid., expressly bars any inquiry into how jurors use material sent into the jury room by the trial court.[7]

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[6] The Federal Rules of Evidence were inapplicable in the state court cases that U.S. Surgical cites. The vast majority of those cases involved extraneous material, and were thus completely inapposite. Three cases were decisions from state supreme courts involving a trial court's submission of a dictionary to a jury. None of those cases is on point. *Smith v. State*, 95 So.2d 525, 527-28 (Fla. 1957), was decided under Florida statutes, not the Federal Rules. Similarly, *Creasey v. Hogan*, 637 P.2d 114, 122-25 (Ore. 1981), was decided under a an Oregon statute that has since been repealed. In addition, the judge in that case submitted a definition of highly specialized terms in a medical dictionary, which were not a matter of "common knowledge." *Compare* cases cited in fn. 9, *infra*. The third case, *Dongo v. Banks*, 448 A.2d 885, 888 (Me. 1982), affirmed the grant of a new trial as a permissible exercise of the "discretion of trial judge." Here, the trial judge also had "broad discretion," *Weiss*, 752 F.2d at 783, and did not abuse it in denying a new trial. *See*, page 18, *infra*.

[7] Rule 606(b) states as follows:

> Upon an inquiry into the validity of a verdict . . ., a juror may not testify as to any matter or statement occurring during the course of the jury's deliberations or to the effect of anything upon that or any other juror's mind or emotions as influencing the juror to assent or

Even assuming *arguendo* that the dictionary was "extraneous," it would have been improper under Rule 606(b) to hold a hearing on the "*effect* the outside information had upon [any] juror." *United States v. Simpson*, 950 F.2d 1519, 1521 (10th Cir. 1991) (emphasis in original). Under the Rule, the only possible issue in an evidentiary hearing was *whether* the jury was provided a standard dictionary by the trial court. Since that issue was not in dispute, a hearing would have been an "exercise in futility." *Id.*[8]

In its briefs and oral argument in the Federal Circuit, U.S. Surgical could not even present a credible hypothesis on how submission of the dictionary might have prejudiced it. In denying U.S. Surgical's motion for a new trial, the district judge carefully considered U.S. Surgical's arguments on possible

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> dissent from the verdict . . . or concerning the juror's mental processes in connection therewith, except that a juror may testify on whether extraneous prejudicial information was improperly brought to the jury's attention or was improperly brought to the jury's attention or whether any outside influence was improperly brought to bear on any juror. Nor may a juror's affidavit or evidence of any statement by the juror concerning a matter about which the juror would be precluded from testifying be received for these purposes.

[8] *Accord: United States v. Duncan*, 598 F.2d at 866 (affirming the denial of a new trial motion, and stating that because of the "limited inquiry permitted by Rule 606(b)," it would have been "futile" to hold a hearing on how jurors used a dictionary they obtained without the trial court's approval .).

prejudice. The district judge recognized, quite properly, that "'the definition of words in our standard dictionaries is taken as a matter of common knowledge which the jury is supposed to possess.'" (Pet. at 30a-31a, quoting *Asherman*, 478 A.2d at 252). He accordingly found that submission of the dictionary did not result in prejudice. *Id.* Even if the dictionary were "extraneous" within the meaning of Rule 606(b), this finding would not be an "abuse" of the trial judge's "broad discretion" in evaluating such matters.[9] *Weiss*, 752 F.2d at 783.

IV. There Is No Reason For This Court To Supervise The Federal Circuit's Application Of Rule 36, Fed.R.App.

U.S. Surgical's final argument is that this Court should grant certiorari to supervise the Federal Circuit's exercise of its authority to issue summary decisions. This authority derives

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[9] Even the injection of extraneous information into jury deliberations is deemed harmless where, as here, the information is merely "common knowledge." *See, Shillcutt v. Gagnon*, 827 F.2d 1155, 1159 (7th Cir. 1987) ("Jurors are expected to bring commonly known facts . . . to bear in arriving at their verdict."); *United States v. McKinney*, 429 F.2d 1019, 1022-23 (5th Cir. 1970), *cert. denied*, 401 U.S. 922 (1971) (same); *In re New York Asbestos Litigation*, 847 F. Supp. 1086, 1100 (S.D.N.Y. 1994) ("An expression of . . . 'general knowledge' does not qualify as 'extraneous prejudicial information' within the exception of Rule 606[b]."). *See also*, Vol. 3, *Weinstein's Evidence*, ¶ 6.06[4] at 606-44 (1995) ("Jurors are expected to bring commonly known facts to bear in assessing the facts presented for their consideration.").

from Rule 36, Fed. R. App., which explicitly states that courts of appeals may render their judgments "without an opinion."

Given the increasing burdens on appellate courts, there are "compelling reasons for the use of summary dispositions in appropriate cases," especially because "many cases do not present any new or significant issue . . . ." *Furman v. United States*, 720 F.2d 263, 266 (2d Cir. 1983). The use of summary opinions permits judges to separate wheat from chaff, and to "devote more time to the remaining cases that truly merit developed exercises of judicial craftsmanship." *Id.* Courts of appeals have broad discretion to determine whether a summary affirmance is appropriate in any given case. *Id.*, 720 F.2d at 265.

That discretion was appropriately exercised here. This appeal was just like many others where an appellee presents a series of meritless arguments to make up in quantity for the absence of any single argument that is sound. It was a perfect candidate for summary affirmance.

U.S. Surgical argues that the summary affirmance "swept presumptively prejudicial error [on the dictionary issue] under the rug." Pet. at 21. But as discussed in Point III, *supra*, the district court's decision on the dictionary was neither error nor prejudicial.

Moreover, the main arguments in U.S. Surgical's appeal brief, including its objections to the sufficiency of the evidence and its list of alleged errors in the instructions on obviousness, *see* App. A at A-1-9, were also devoid of merit. U.S. Surgical does not, and cannot, find fault with the Federal Circuit's rejection of these arguments in a summary affirmance. Nothing about the summary affirmance warrants this Court's review.

CONCLUSION

For the reasons set forth above, this Court should deny U.S. Surgical's petition for a writ of certiorari.

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APPENDIX

IV. ARGUMENT

A. U.S. Surgical's '420 and '057 Inventions Were Not Obvious As A Matter Of Law

This Court reviews the legal conclusion of obviousness de novo; any underlying factual determinations must be reversed where unsupported by substantial evidence. Structural Rubber, 749 F.2d at 718-19, 223 USPQ at 1272-73; In re Donaldson Co., 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc). An obviousness verdict must be overturned unless supported by clear and convincing evidence. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1565-66, 1 USPQ2d 1593, 1594-95 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). The infringer must prove clearly and convincingly that the claim as a whole -- interpreting each means-plus-function element in light of the structures described in the specification -- would have been obvious to one of ordinary skill. Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1848-49; Gillette Co. v. S.C. Johnson & Son, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990).

Ethicon failed to provide any evidence that the claims at issue, taken as a whole and interpreted in light of the structures described in the specification, would have been obvious. Rather, Ethicon's evidence focused on the "concept" of an endoscopic multiple clip applier, and sought to persuade the jury that this concept was obvious.[1] In the absence of any

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[1] The record on this point is clear: Ethicon's witnesses -- mechanical expert Mann and engineer Love -- could testify only that the "concept," not the claimed invention, was obvious. *See* A. 583 (Tr. 2246-48); A. 520

evidence that the claims as a whole would have been obvious, the issue was never a jury issue. The jury, with no factual basis, and per force in the absence of evidence that was clear and convincing, simply ignored and overrode the presumption of validity.

1. The Prior Art Did Not Teach or Suggest

In its post-trial opinion, the District Court, invoking this Court's decision in Ashland Oil, Inc. v. Delta Resins & Refactories, Inc., 776 F.2d 281, 293, 297 & n. 24, 227 USPQ 657, 667 & n. 24 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986), accurately described the first prong of the "obviousness" standard, namely, "that the prior art would have taught or suggested, to the person of ordinary skill, the combination of individual elements found in the patented device . . . ." A. 22.

Here, the parties' own conduct demonstrates that no such showing was remotely possible. U.S. Surgical was way ahead of the art. In 1985, it conceived of an endoscopic multiple clip applier which it believed would have application in general surgery. In 1987, it began serious design and engineering efforts, including initial model making. By contrast, when Ethicon first began to think about an endoscopic clip applier in 1989, it thought in terms of importing a single clip applier from a European affiliate[2] -- which is what the prior art did teach to one of ordinary skill. As of the date U.S. Surgical filed its '420 patent application, Ethicon was still working on its Gen-II open multiple clip applier with a ratchet feed system to compete with U.S.

(Tr. 1892).

[2] See n. 14, supra.

Surgical's Premium Surgiclip. Ethicon did not consider developing an endoscopic multiple clip applier until after the October 1989 ACS Convention, until after it had obtained and examined U.S. Surgical's ENDO CLIP, and until it had observed the ENDO CLIP's remarkable commercial success.

By July 1989, when U.S. Surgical applied for its '420 patent, multiple clip appliers for open surgery and endoscopic single clip appliers had co-existed for a decade. Nothing in the prior art suggested or taught the claimed endoscopic multiple clip applier. No one had made an endoscopic multiple clip applier, and no one was motivated to try except, of course, U.S. Surgical. U.S. Surgical alone had foreseen the desirability and need for an endoscopic multiple clip applier. It was clear that, given these circumstances and this prior art, it simply was not obvious to a person of ordinary skill in the art to try to make the claimed invention when U.S. Surgical applied for its patent in 1989. See, e.g., In re Shaffer, 229 F.2d 476, 480, 108 USPQ 326, 329 (C.C.P.A. 1956) (non-obviousness supported where problem that invention addressed "was not recognized in the prior art," and problem was "heretofore unknown").

In reaching out for evidence that might sustained the jury's verdict, the District Court relied on Polk '239, and endoscopic device that applied elastic loops to fallopian tubes, as giving "suggestion, incentive, or motivation to make the claimed invention." A. 24 at n. 20.[3] Ethicon's mechanical

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[3] The Polk applicator applies rubber rings which are manually stretched onto the extension of the device. A. 763-64 (col.5, lines 1-4; col. 7, lines 50-58). These structures are completely different from the claimed clip applier. The ring closes by itself through elastic memory

expert, Professor Mann, admitted, however, that this reference taught *away* from the claimed invention; it did not relate to surgical clips and was not useful for ligating arteries and vessels. A. 582 (Tr. 2241-42). The reference not only fails to support the verdict but, in fact, is inconsistent with it.

2. The Prior Art Did Not Show How To Obtain The Desired Result

In its post-trial opinion, the District Court, invoking this Court's decision in In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990), accurately described the second prong of the "obviousness" standard, namely, "that the prior art would sufficiently teach or direct one of ordinary skill 'how to obtain the desired result." A. 22; see also Gillette, 919 F.2d at 724-25, 16 USPQ2d at 1928.

The testimony of Ethicon mechanical expert Mann and its engineer Love that U.S. Surgical's invention was not obvious and was difficult to do, as set forth at pp. 16-17, supra, proves that no engineer of ordinary skill based on the prior art would enjoy a reasonable likelihood of success at making the '420 and '057 invention -- which must be dimensioned to work through a standard trocar, as recited in the '420 specification. A. 144 (col. 4, lines 12-16).

In the numerous drawings and detailed specification of its patents, U.S. Surgical enabled persons of ordinary skill to make an (efficacious) endoscopic multiple clip applier. U.S. Surgical set out its choices, including its

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and is not closed by any action of the device itself. A 764 (col. 8, lines 8-16, 27-31). The Polk applicator is not a hemostatic ligating device. A. 642-43 (Tr. 2565-66).

selection of an appropriate clip storing system, clip advancing system, clip closing system, and sealing system, and its patent claims reflect these choices. Donaldson, 16 F. 3d at 1193, 29 USPQ2d at 1848-49. By contrast, in July 1989, when U.S. Surgical applied for the '420 patent, Ethicon was pursuing alternative choices, including an inappropriate clip advancing system (a ratchet) for a thin profile, multiple clip applier for open surgery. Given the state of Ethicon's own clip applier art, it is no wonder that Ethicon's witnesses had to concede that the prior art did not show how to obtain the '420 and 057 inventions. A. 520 (Tr. 1892); A. 583 (Tr. 2246-48).

In its post-trial opinion, the Court asserted in note 22 that "the testimony of experts and inventors" provided substantial evidence to support the jury's finding, but the Court did not refer in the record to what it had in mind. A. 25. It was not allowed, of course, to rely on the testimony of any U.S. Surgical inventor in place of the hypothetical person of ordinary skill. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454, 227 USPQ 293, 297-98 (Fed. Cir. 1985). And Ethicon's mechanical expert, Professor Mann, supported U.S. Surgical's position, not Ethicons. A. 583 (Tr. 2246-48).

There is no arguable basis in the record for the jury's finding that the prior art taught an engineer of ordinary skill how to make an efficacious endoscopic multiple clip applier at the time of U.S. Surgical's invention.

3. Second Considerations Strongly Support Non-Obviousness

The secondary consideration of commercial success is rearly as evident in this case. U.S. Surgical's ENDO CLIP

was a huge commercial success due to its patented features, and the same was true of the infringing EMCA/ERCA. See pp. 12-13, 21, supra. The commercial success of these novel products strongly supports the legal conclusion of non-obviousness. Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1575, 24 USPQ2d 1321, 1335 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1053, 5 USPQ2d 1432, 1440 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

4. No Evidence Overcomes The Presumption Of Validity

This Court should rule that the claims at issue were not obvious as a matter of law when, as here, the ENDO CLIP was the first endoscopic multiple clip applier; the relevant prior art co-existed for a decade before the invention, the Examiner considered the most relevant prior art during prosecution of the patents, and the claims at issue are presumptively valid over the prior art; no prior art suggested the claimed combination; the infringer's own mechanical expert and senior engineer acknowledged that U.S. Surgical's invention was not obvious and was difficult to do; and the infringer conceded that the invention was an enormous commercial success due to its patented features.

B. Alternatively, Prejudicial Deficiencies In Obviousness Instructions Require a New Trial

The Court "review[s] the adequacy of the jury instruction for prejudicial legal error." Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1563, 28 USPQ2d 1081, 1087 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1540 (1994); see also Jamesbury Corp. v. Litton Indus. Producs. Inc., 756 F.2d 1556, 1558 225 USPQ 253, 255 (Fed. Cir. 1985).

In this case, U.S. Surgical's ENDO CLIP invention was left to an unguided and misled jury. The District Court stood by while Ethicon, the infringer, repeatedly stressed improper and prejudicial themes -- e.g., that the U.S. Surgical invention was "easy" and therefore obvious; that the presumption of validity was weakened because U.S. Surgical withheld the Premium Surgiclip '226 patent from the Patent Office notwithstanding Judge Eginton's contrary and correct ruling that the '226 patent was cumulative and not material; that the absence of certain "secondary considerations" supported a finding of obviousness; that prior art that teaches away from an invention can support a finding of obviousness; and, perhaps most egregious of all, that enforcement of U.S. Surgical's patents hindered competition, requiring a verdict in Ethicon's favor. The District Court failed to rein in Ethicon's counsel and, to compound the problem, refused to construe the meaning of the claims for the jury, despite the fact that the claim language was clear and all of the relevant terms were well-defined in the specification. The Court's failure to give critical curative and other instructions was of crucial importance in defending against the infringer's claim of obviousness, and seriously prejudiced U.S. Surgical.

○ No "Manner of Invention" Instruction: The Court's refusal to instruct in terms of the last sentence of 35 U.S.C. § 103 is not defensible. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1547, 220 USPQ 193, 198 (Fed. Cir. 1983) (obviousness "instructions should track the statute, 35 U.S.C. § 103"); Shiley, Inc. v. Bentley Lab. Inc., 794 F.2d 1561, 1568, 230 USPQ 112, 115-16 (Fed. Cir. 1986) (jury "correctly instructed that patentability of an invention does not depend on how the invention was made"); S. Rep. No. 1979, 82d Cong., 2d Sess. 18 (1952), reprinted in 1952 U.S.C.C.A.N. 2411 (statutory language means it is "immaterial whether [invention] resulted from long toil and experimentation or from a flash of genius"). See pp. 22-23,

supra. The absence of such an instruction was particularly prejudicial in light of Ethicon's heavy reliance throughout trial and in closing on U.S. Surgical's alleged "ease" of invention. This error was especially grievous because the Court's refusal to correct Mr. Ryther's wrong legal construction, *see* pp. 22-23, supra, left the jury with the misimpression that Ethicon was correct that the manner of invention could negative patentability.

- No "'226 Patent As Cumulative" Instruction: The Court's refusal to give an instruction that the Premium Surgiclip '226 patent was cumulative, in accordance with the inequitable conduct summary judgment ruling in U.S. Surgical's favor, was also grave because the '226 patent was not brought to the attention of the Examiner, see pp. 23-24, supra, had the effect, without a curative instruction, of wrongly undercutting the statutory presumption of validity. See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) (prior art not before the Examiner that is "merely pertinent" does not make the burden of proving invalidity easier to overcome), cert. denied, 469 U.S. 851 (1984).

- No "Absence of Secondary Considerations" Instruction: The Court's refusal to instruct the jury that the absence of secondary considerations was a neutral factor that was in no way probative of non-obviousness was serious error. E.g., Medtronic, Inc. v. Intermedics, Inc., 799 F.2d 734, 739 & n. 13, 230 USPQ 641, 643 & n. 13 (Fed. Cir. 1986), cert. denied, 479 U.S. 1033 (1987); Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d955, 960, 1 USPQ2d 1196, 1199 (Fed. Cir. 1986). In the absence of appropriate instruction, Ethicon was permitted to undermine improperly the undisputed "commercial success" of the ENDO CLIP as a secondary consideration favoring non-obviousness. See pp. 24-25, supra. It wrongly penalized U.S.

Surgical for being so far ahead that there were no long-felt need or attempts by others because no one was even working in the area. See Uniroyal, 837 F.2d at 1053, 5 USPQ2d at 1440 ("Even though demand increased after the oil crisis, the court overlooked the fact that it was the claimed invention to which the industry turned, and it was the uniqueness of the claimed invention which made this so").

○ No "Taught Away" Instruction: The Court's refusal to give the jury a "taught away" instruction, in light of Ethicon's reliance on prior art that actually taught away (e.g., Polk '239, A. 755), was also serious error, since such evidence, see p. 25, supra, can be an important indicator of non-obviousness. E.g., In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

○ No "Meaning of Claims" Instructions: The Court's refusal to instruct the jury on the meaning of the patent claims necessarily prejudiced the jury's consideration of obviousness. *Genentech*, ___ F.3d ___, 31 USPQ2d at 1165, 1172 & n. 47 (error to "fail[] to instruct the jury on the proper claim construction it was to apply"); Read 970 F.2d at 822 & n. 3, 23 USPQ2d at 1432 & n. 3. In this case, Ethicon argued that, if the accused devices infringed, then U.S. Surgical's claims covered the broadest of structures, such as any jaws or any seal means, and that the claims were therefore obvious. See, e.g., A. 578 (Tr. 2214); A. 598 (Tr. 2325-26); A 672-73 (Tr. 2708-09). This portrayal of the claims completely ignored the specific limitations in the patent claims and specification, and for which U.S. Surgical had sought specific instructions. A. 81-97, 101-09; A. 578 (Tr. 2214). Failure to give such instruction was highly prejudicial error when, as here, the infringer's obviousness defense turned on an abusive misreading of the patent claims. See *Beachcombers, Int'l, Inc. v. Wildewood Creative Products*, No. 93-1258, 1994 U.S. App. LEXIS 19881, at *15 (Fed. Cir. Aug. 3, 1994) ("first

step in [obviousness analysis] involves the proper interpretation of the claims"); Smithkline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 885, 8 USPQ2d 1468, 1474 (Fed. Cir. 1988); Panduit, 810 F.2d at 1576, 1 USPQ2d at 1603 ("[w]hen the prior art is compared with erroneously interpreted claims, findings of differences between the prior art and the claims will necessarily be clearly erroneous").

o No Curative Instruction Regarding Competition: The District Court, despite promising to deal with Ethicon's policy argument for competition notwithstanding the patent law, never did so. Defense counsel at every turn, from opening to closing, in examination and cross-examination, including repetition of blatantly improper question on which objection had been previously sustained, made competition the centerpiece of Ethicon's defense. See pp. 26-28, supra. The peroration in closing to "honor competition" was an appeal for jury nullification. A. 673 (Tr. 2710). This Court fully appreciates the argument to this effect in a jury case is a "serious impropriety," likely to be prejudicial," and warrants a curative instruction. Jamesbury, 756 F.2d at 1559, 225 USPQ at 255. Since Ethicon's argument that it be allowed to sell its infringing products in the name of competition was the main theme of its defense, the resulting prejudice was as unfortunate and as extreme as can be found in a patent trial record. Eli Lilly & Co. v. Premo Pharmaceutical Labs, Inc., 630 F.2d 120, 138 (3d Cir.) ("Congress has determined that it is better for the nation in the long-run to afford the inventors of novel, useful, and non-obvious products short-term monopolies on such products than it is to permit free competition in such goods"), cert. denied, 449 U.S. 1014 (1980); Smith Int'l Inc. v. Hughes Tool Co., 718 F.2d 1573, 1577-78, 219 USPQ 686, 689-90 (Fed. Cir.), cert. denied, 464 U.S. 996 (1983).

The deficiencies in "obviousness" instructions, individually and together, and in combination with the Court's failure to control Ethicon's competition theme, deprived U.S. Surgical of its right to an "informed and . . . fair verdict []," Structural Rubber, 749 F.2d at 713, 223 USPQ at 1268 (emphasis in original), and clearly require a new trial on obviousness.

C. Submission Of The Dictionary Requires A New Trial On Obviousness

The District Court's provision of dictionary to the jury for use in its deliberations is reviewed by this court to determine whether its submission was presumptively prejudicial and here, since the presumption was unrebutted, necessarily requires a new trial. United States v. Weiss, 752 F.2d 777, 782-83 (2d Cir.), cert. denied, 474 U.S. 944 (1985).

When the District Court provided the jury with Webster's New World Dictionary over the objection of both parties, it created a presumption of prejudice following from the exposure of the jury to extraneous none-record material under the applicable law of the Second Circuit. Weiss, 752 F.2d at 782-83[4] Ethicon did not rebut this presumption of prejudice. The District Court therefore had two choices: it

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[4] The District Court's provision of the dictionary to the jury raises procedural issues not within the Court's unique jurisdiction. In such circumstances, this Court has held that the controlling law is that of the regional circuit in which the case was tried. Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 855-58, 20 USPQ2d 1252, 1256-59 (Fed. Cir. 1991), cert. denied, 112 S. Ct. 2957 (1992).

could set aside the jury verdict or, if it wanted to ascertain whether there was in fact prejudice, it could hold a hearing as requested by U.S. Surgical. It did neither.

The District Court's denial of U.S. Surgical's new trial motion on this point deprived U.S. Surgical of the presumption of prejudice mandated by the Second Circuit. The District Court assumed that the jury used the dictionary to discover the ordinary meaning of words used in the patent claims. A. 34. If so, the jury's use of the dictionary elegantly underscores the Court's own failure to define the meaning of the claims, with its prejudicial impact on the jury's consideration of "obviousness ," as already discussed, pp. 43-44, supra. It is equally likely that the jury also used the dictionary to look up the meaning of words such as "presumption" (as used in "presumption of validity"), "obviousness," or some other word laden with legal content in the patent world. Structural Rubber, 749 F.2d at 723, 223 USPQ at 1276. The whole reason that prejudice is presumed from a jury's consideration of such extraneous matter is precisely to avoid such speculation. Stiles v. Lawrie, 211 F.2d 188, 190 (6th Cir. 1954).

The District Court justified its submission of the dictionary to the jury by assuming that its use accorded with the standard instruction in patent cases to consider the "ordinary meaning" of claim language as interpreted by one of ordinary skill in the art. A. 34; A. 676-77 (Tr. 2732-33). Such reasoning must be of particular concern to this Court. Inevitably, giving a jury a dictionary will deprive the patentee of his right to be his own lexicographer, will override a trial court's definition of terms in its own instructions, and is also inconsistent with the requirement that the meaning of a claim be as understood by a person of ordinary skill in the art, not a lay jury with a standard dictionary. Absent a clear holding rejecting the District Court's rationale, this impermissible and

presumptively prejudicial practice will repeat itself to the complete debasement of a fair patent trial, as occurred below.

The District Court's placing of the burden to show prejudice on U.S. Surgical was but a denial of the clear law of the Second Circuit. Since Ethicon did not rebut this presumption of prejudice, this Court has no alternative under the applicable law of the Second Circuit but to order a new trial if it cannot determine '420 validity as a matter of law.

D. The Accused Devices Infringe Claims 1, 2 and 7 Of The 057 Patent As A Matter Of Law

A determination of the scope and meaning of a claim is a question of law that is review de novo. Read, 970 F.2d at 821, 23 USPQ2d at 1431; North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 1575, 28 USPQ2d 1333, 1336 (Fed. Cir. 1993). This Court reviews the jury's verdict of non-infringement, assuming proper claim construction, for substantial evidence. Genentech ___ F.3d at ___, 31 USPQ2d at 1165 n. 6, 1168-69; Read 970 F.2d at 821, 23 USPQ2d at 1431.

In light of the '420 infringement finding, the only possible infringement issue on appeal relates to clip advancing means. Ethicon argued below that the EMCA/ERCA's clip advancing structure was not the same as or equivalent to that covered in '057 claim elements 1(b)(ii) and 7(b)(iii), because: its pusher bar was wider or stiffer than the pusher bar in the patent specification and performed the additional function of assisting in holding a clip in the jaws; it had a single upstanding tab, the so-called "primary valve," as an escapement means as opposed to the two upstanding tabs disclosed in the patent specification; and its clip advancing system included additional structure not found in the patent

specification -- clips were in two planes with a "lifter spring" to assist the clip on its path to the jaws after it had moved past the escapement tab. A. 564-65 (Tr. 2143-46); A. 557-58 (Tr. 2099-2107); A. 566 (Tr. 2154-56). All of these arguments, however, ignore the definition in the patent specification for clip advancing means as a longitudinally slidable pusher bar/escapement system, structure that found in the EMCA/ERCA and that Ethicon chose for the clip advancing from among other available alternatives. A. 170 ('057 patent, col. 3, lines 42-51); A. 498-99 (Tr. 1778-84); A. 512-13 (Tr. 1855-57).

The fact that additional structure is employed in the course of advancing clips to the jaws after the escapement or that the pusher performs a function in addition to clip advancing merely reflects that the accused devices have added features; it does not take the accused devices outside claim elements 1(b)(ii) and 7(b)(iii). See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 945, 15 USPQ2d 1321, 1332 (Fed. Cir.) ("The addition of features does not avoid infringement, if all the elements of the patent claims have been adopted. Nor is infringement avoided if a claimed feature performs not only as shown in the patent, but also performs an additional function") (citation omitted), cert. denied, 498 U.S. 920 (1990). Nor does the claim language limit the pusher bar or escapement to a specific shape or size. Based on the prior art, one-tab and two-tab escapement to a specific shape or size. Based on the prior art, one-tab and two-tab escapement structures were clearly recognized to be structurally equivalent. A. 342 (Tr. 910-14). To permit the accused EMCA/ERCA to escape infringement by changing the size or shape of the pusher bar or by joining the points of two upstanding tabs to make a one-tab escapement trivializes the

'057 patent and deprives U.S. Surgical of deserved and necessary protection.[5]

Careful patent drafters writing means-plus-function claims define the "means" in the specification. Genentech, ___ F.3d at ___, 31 USPQ2d at 1167-68; Donaldson, 16 F.3d at 1195-96, 29 USPQ2d at 1850-51. The defination then sets out the scope of the patent grant as to that means. There is no principled argument for honoring the definition in the specification. Beachcombers, 1994 U.S. App. LEXIS 19881, at* 8-9; Genentech Inc., ___ F.3d at ___, 31 USPQ2d at 1167-68, 1170; McGill, Inc. v. John Zink Co., 736 F.2d 666, 674, 221 USPQ 944, 949-50 (Fed. Cir. 1984); cf. D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1572-73, 225 USPQ 236, 237-38 (Fed. Cir. 1985). Here, the clip advancing means in the '057 patent was defined in the specification as a pusher bar and an escapement means, which consisted of a plurality of upstanding tabs. A. 170 (col. 3, lines 42-51). If this Court applies the definition of clip advancing means contained in the '057 specification, it is clear that the accused devices literally infringe claim 1, as they have the same (pusher bar) and equivalent (one escapement tab for two tabs) structure, A. 498-99 (Tr. 1780-84); A. 586 (Tr. 2264-66); A. 590 (Tr. 2279-80); hence dependent claims 2 and claim 7 of the '057 patent are also infringed.

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[5] The jury rejected a similar argument when it found the EMCA/ERCA to infringe '420 claim 1, despite Ethicon's argument that it escaped infringement because its jaws were narrower than the ENDO CLIP's jaws and could fit down a 10 mm trocar without compressing.

Since the accused devices have all the means and structures recited in the '057 claims at issue, this Court should rule that they infringe as a matter of law.

E. Alternatively, This Court Must Order A New Trial on '057 Infringement

This Court reviews the adequacy of jury instructions, taken as a whole, for prejudicial legal error. See p. 40, supra. The District Court refused to construe the meaning of the key terms of the '057 patent for the jury, contrary to the clear law of this Court. Genentech, ___ F.3d at ___, 31 USPQ2d at 1165 n. 6, 1172 n. 47; Read, 970 F.2d at 822-23 & n. 3, 23 USPQ2d at 1432 & n. 3; Johnston v. IVAC Corp., 885 F.2d 1574, 1579, 12 USPQ2d 1382, 1385-86 (Fed. Cir. 1989). It rejected U.S. Surgical's jury instructions which set forth the meaning of the patent terms. U.S. Surgical was plainly prejudiced by the submission of unconstrued claims to the jury, and a new trial is therefore required. Genentech, ___ F.3d at ___, 31 USPQ2d at 1165, 1172 n. 47.

F. In Addition, Submission Of The Dictionary Requires A New Trial On '057 Infringement

For the same reasons that submission of the dictionary to the jury requires a new trial on "obviousness," it also requires a new trial on '057 infringement. See, pp. 45-47, supra.

(3)

Supreme Court, U.S.
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No. 94-2081

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

UNITED STATES SURGICAL CORPORATION,
Petitioner,

v.

ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITIONER'S REPLY BRIEF

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REPLY ARGUMENT

Ethicon cannot dispute that U.S. Surgical raised the *Markman* issue [1] below, and that the appellate panel did not apply the holding of *Markman* in this case. Nor is Ethicon able to advance any rational reason why this case should be treated any differently than *Markman* with regard to the issue of patent claim construction. Faced with these facts, Ethicon repeatedly mischaracterizes the *Markman* issue as a "minor tangent" of U.S. Surgical's case below, Ethicon Brief ("Eth. Br.") at 7, 9, and tries to argue the absence of prejudice, *id. at* 8-9, 13. Ethicon is wrong on both counts; U.S. Surgical clearly pressed the *Markman* issue both at trial and on appeal, and was severely prejudiced.

1. U.S. Surgical Squarely Presented The *Markman* Issue In The Courts Below

The trial history shows that U.S. Surgical, based on *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992), persuaded the initial judge that he was required to define the scope and meaning of the claims for the jury, only to find that the judge later assigned to try this case, relying on *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991), accepted the contrary view.[2] U.S. Surgical continued to press its position, as the trial judge expressly noted in his post-trial ruling: "At trial, U.S. Surgical urged the court to instruct the jury on the meaning of the four patent claims at issue." Petitioner's Appendix ("P.A.") 24a.

U.S. Surgical submitted detailed instructions to the trial court supporting its position on the patent claims' mean-

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[1] *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3068 (U.S. July 3, 1995) (No. 95-26).

[2] Ethicon asserts that the trial judge followed "then-controlling Federal Circuit precedent," Eth. Br. at 6, but CAFC precedent was in conflict, and *Read* was surely the stronger precedent, as the CAFC held in *Markman*.

ing. P.A. 24a, n.26.[3] Had the trial judge followed *Read* instead of *Tol-O-Matic*, these instructions would have been given.[4] The trial judge rejected meaning-specific instructions in favor of boilerplate instructions. R.A. 1a-4a.

On appeal, U.S. Surgical's major premise was that the trial court should have defined the claims' meaning for the jury as a matter of law, and that its failure to do so deprived U.S. Surgical of a meaningful patent trial. P.A. 44a-45a. As U.S. Surgical argued, one consequence of the trial court's abdication of its role as law-giver was the jury's request for a dictionary. P.A. 44a-45a.

In its opening brief on appeal, U.S. Surgical argued that it was entitled to prevail on obviousness and '057 infringement but, failing that, was entitled to a new trial because of the trial court's failure to define the scope and meaning of the claims for the jury. Ethicon's Appendix ("Eth. A."), A-7, A-9 to A-10, A-16. Having highlighted this issue in its summary of argument, and having staked its position squarely on the correctness of *Read*, U.S. Surgical argued that the trial court abdicated its responsibility under *Read*.[5] U.S. Surgical also reiterated this position in its CAFC Reply Brief. U.S. Surgical CAFC Reply Brief at 1, 18-20.[6]

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[3] These instructions are reproduced in the appendix to this brief, Reply Appendix ("R.A.") 5a-26a.

[4] Ethicon's argument that the requested instructions contained error, Eth. Br. at 12, is both incorrect and irrelevant, since any dispute would have been resolved at the instructional stage.

[5] In its appellate brief, U.S. Surgical set up the refusal of the trial court to instruct the jury on the scope and meaning of the claims in its statement of the case, and stressed the issue's importance in its new trial argument on obviousness. Eth. A, A-7, A-9 to A-10 ("and, to compound the problem, refused to construe the meaning of the claims for the jury"). U.S. Surgical reiterated this position in support of its new trial argument on '057 infringement. Eth. A, A-16.

[6] U.S. Surgical concluded its reply argument as follows: "The Court's limited charge on claim construction, comprising less than

Given U.S. Surgical's emphasis on the trial court's failure to define the meaning of the claims, it is irresponsible for Ethicon to assert, Eth. Br. at 7, that the question of who construes the claims "was a minor tangent in U.S. Surgical's appeal brief." To the contrary, the fundamental flaw throughout the patent trial was the court's refusal to tell the jury what the patent claims meant. That was the reason U.S. Surgical chose this issue as a major theme of its argument. P.A. 44a-45a.[7]

2. U.S. Surgical Was Prejudiced On Obviousness By The Trial Court's Failure To Define The Scope And Meaning Of The Claims [8]

As Ethicon advised the CAFC:

> There was a sharp dispute at trial on how a person of ordinary skill in the art would construe the claims. To be sure, each side's experts thought that the meaning of the claims was clear—but they construed the claims in ways that could not have been more divergent.

Ethicon's CAFC Answering Brief at 28-29. The CAFC has long recognized that failure to define the scope and meaning of patent claims is prejudicial error in "obvious-

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two pages of abstract statements of law, A. 676-77 (Tr. 2732-34), was no substitute for meaning-specific instructions. That the parties set forth divergent views of the claims in testimony and charts, Eth. 29-30, only underscores the need for accurate instruction. Far from providing 'meticulous instructions,' Eth. 30, the District Court ignored its obligation to instruct the jury on the meaning of the claims." U.S. Surgical CAFC Reply Brief at 20.

[7] Ethicon erroneously argues that the CAFC "selected" *Markman*, as opposed to this case, as the vehicle for *en banc* consideration of the roles of court and jury in claim construction. Eth. Br. at 11. The CAFC ordered rehearing *en banc* in *Markman* on November 5, 1993, months before this case was tried in the District Court in January 1994.

[8] Ethicon apparently concedes that U.S. Surgical was prejudiced on the '057 infringement issue. U.S. Surgical prevailed on '420 infringement. Ethicon's argument of no prejudice focuses only on obviousness.

ness" analysis; definition is imperative in order to compare the claimed invention with the prior art. *See, e.g., Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir.) ("When the prior art is compared with erroneously interpreted claims, findings of differences between the prior art and the claims will necessarily be clearly erroneous."), *cert. denied*, 481 U.S. 1052 (1987). U.S. Surgical sought specific instructions defining its patent claims, so that the jury could compare properly-construed claims to the prior art for the purpose of determining "obviousness." R.A. 5a-17a, 19a-26a; Eth. A., A-9 to A-10. This did not happen. The prejudice to U.S. Surgical was that the jury, in a case in which claim meanings were sharply disputed, was allowed to determine obviousness without being instructed on what the claims meant. Equally important, the jury had no opportunity to develop an appreciation for the specific limitations of U.S. Surgical's patent claims, as U.S. Surgical had urged. U.S. Surgical detailed its position on prejudice in its CAFC Brief. Eth. A, A-9 to A-10.[9]

A patent is born valid and carries with it a presumption of validity, 35 U.S.C. § 282, which may be rebutted only by clear and convincing evidence. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810 (1986). Without properly defined claims, an infringer's task on obviousness becomes substantially easier, because the jury is more likely to accept generalized assertions that the Patent Office mistakenly allowed claims that were too

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[9] Ethicon also asserts that U.S. Surgical's patent law engineering experts agreed that prior art open clip appliers would constitute the claimed invention if they were merely sealed and had a long shaft. Eth. Br. at 4. U.S. Surgical's experts, however, clearly testified that simply desiring an instrument having the claimed features was not enough to make the claims obvious; one also would have had to know how to make the claimed instrument, as taught by U.S. Surgical's patents. A. 455 (Tr. 1533); A. 386 (Tr. 1157-58). U.S. Surgical's engineering expert noted that "no one could get to an endoscopic multiple." A. 386 (Tr. 1158). *See* n.10, *infra*.

broad and therefore obvious from the prior art. On the other hand, if the scope and meaning of the claims are defined by the court, it is more difficult for an infringer to use arguments not tied to the claim's limitations to induce an obviousness verdict.

In this case, Ethicon took maximum advantage of the trial court's failure to define the claims' scope and meaning. Ethicon asserts that U.S. Surgical sought a broad claim interpretation "to try to preempt the entire field by advocating the broadest possible construction of the claims." Eth. Br. at 3. As U.S. Surgical pointed out below, Eth. A., A-9, this was *not* U.S. Surgical's position; it was the way Ethicon repeatedly and abusively mischaracterized U.S. Surgical's position. It was Ethicon, the infringer, that strenuously resisted U.S. Surgical's efforts to have the trial court define the claims, so that Ethicon could argue in closing, as it repeatedly did, R.A. 27a, that U.S. Surgical's claims had no boundaries and therefore were obvious from the prior art. Ethicon thereby induced an improper verdict of obviousness.

Ethicon further asserts that U.S. Surgical was not prejudiced by the trial court's failure to define the claims, because U.S. Surgical's proposed instructions broadly claimed "a long, sealed version of a generic multiple clip applier." [10] Ethicon argues that had U.S. Surgical's proposed instructions been given, the jury would have found the invention obvious anyway. Eth. Br. at 3-6, 11. While one cannot know what construction the jury gave the patent claims, the instructions requested by U.S. Surgical belie Ethicon's argument. These instructions show that U.S. Surgical undertook to review each claim and re-

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[10] Ethicon cannot dispute that U.S. Surgical's ENDO CLIP™ was an important technological feat. Ethicon's trial witnesses were certainly of this view. *See, e.g.*, A. 520 (Tr. 1892); A. 582 (Tr. 2247) (Ethicon's engineering expert testified: "The invention of a particular configuration of multiple endoscopic multiple clip applier, and its reduction through engineering to a merchandisable product is not obvious.").

quested the trial court to define the meaning of each claim element for the jury, including the specific mechanical structures identified by each claim element. R.A. 5a-17a, 19a-22a. For example, properly construed, the "means for closing clips" required a pair of flexible opposing jaws, not *any* jaws as Ethicon argued. *Compare* R.A. 7a-8a, 12a, 19a-20a (U.S. Surgical's proposed instructions) *with* R.A. 27a (Ethicon's closing argument) *and* R.A. 28a (U.S. Surgical's closing argument).[11] The instructions, if given, clearly would have conveyed to the jury that the claims were a combination of specific structural elements in an endoscopic instrument and that their particular combinations, not some general concept, had to be found obvious.[12]

In short, U.S. Surgical suffered the well recognized prejudice flowing from an obviousness determination without proper claim construction, compounded by the infringer's improper argument that the claims, in the abstract and without any definition, were too broad and therefore obvious from the prior art.

3. This Court Should Grant Certiorari Or Hold This Case In Abeyance Pending *Markman*

Ethicon argues that the CAFC rejected U.S. Surgical's petition for rehearing *en banc* on the claim construction issue knowing the outcome of *Markman*, because it concluded that U.S. Surgical was not prejudiced by the trial

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[11] To counter Ethicon's improper arguments, U.S. Surgical also introduced into evidence a commercial endoscopic multiple clip applier (PX 228) made by Origin (Eli Lilly) which, unlike Ethicon's product, did not have a pair of flexible opposing jaws. Thus, the Origin product did not have all the specific structures of U.S. Surgical's claims, as properly construed, and therefore did not infringe those claims. The purpose was to show the fallacy of Ethicon's overbroad assertions of claim scope. But the jury, without the claims being defined for it, never developed an appreciation that there were well-defined limits on the reach of the claims.

[12] That is why the Patent Examiner allowed the claims; he was fully familiar with open clip applier art and, of course, knew that endoscopic instruments had to be long and sealed.

court's refusal to define the claims for the jury. Eth. Br. at 12-14. This is sheer speculation totally lacking in merit. Under Circuit Rule 36, the CAFC will not entertain an *en banc* petition from a panel's summary disposition. Such disposition removes any opportunity for *en banc* consideration, because a petitioner cannot identify points of law or fact overlooked or misapprehended by the panel. Fed. R. App. P. 40(a); Circuit Rule 40 (b)(2). That is the very mischief resulting from the procedures followed by the panel below that needs this Court's attention.

4. The Federal Circuit's Decision On The Dictionary Issue Conflicts With All Known Precedent

It is universally acknowledged that a jury's consultation of a non-evidential dictionary is error. Certainly, there are cases in which trial and appellate courts have concluded, *based on knowledge of the word or words looked up by the jury* and comparing them with the court's instructions, that a new trial was not warranted. *See, e.g., United States v. Cheyenne*, 855 F.2d 566 (8th Cir. 1988); *Connectiut v. Asherman*, 478 A.2d 227, 252 (Conn. 1984), *cert. denied*, 470 U.S. 1050 (1985). Even in those cases, however, giving a dictionary to the jury is condemned. *See, e.g., Asherman*, 478 A.2d at 252.[13] Courts often conclude that a new trial is required. *See, e.g., Wernsing v. General Motors Corp.*, 470 A.2d 802, 809 (Md. 1984). But, so far as petitioner is aware, there is no case in which a new trial was not ordered when, as in this case, the jury made use of a dictionary, the words or words looked up are unknown, and the trial

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[13] Like Ethicon, the trial judge relied on *Asherman* (a Connecticut state court case) to justify having given the dictionary to the jury. P.A. 30a. But *Asherman* warns against giving the jury a dictionary, relying on *Oregon v. Holmes*, 522 P.2d 900, 905 (Or. Ct. App. 1974), a case directly on point. In *Holmes*, prejudice was presumed and a new trial ordered, because the trial court provided the jury with a dictionary over both parties' objections and the words looked up were unknown.

court declined to hold a hearing to ascertain what words were looked up by the jury.

Ethicon argues, as it did below, that the dictionary was not extraneous, because its submission during the jury's deliberations was the functional equivalent of a court exhibit being given to the jury as permitted under Rule 614, Fed. R. Evid. Eth. Br. at 15. This argument is flatly contrary to the fundamental evidentiary principle that a jury should base its decision "on proofs taken openly at the trial, free from all danger of extraneous influences." *Palestroni v. Jacobs*, 77 A.2d 183, 185 (N.J. Super. Ct. App. Div. 1950) (Brennan, J.) (a dictionary case) (quotation omitted).

Ethicon asserts that U.S. Surgical never presented the CAFC with a "credible hypothesis on how submission of the dictionary might have prejudiced it." Eth. Br. at 17. As U.S. Surgical pointed out in the CAFC (and also in the trial court), under controlling Second Circuit precedent the burden was on Ethicon, not U.S. Surgical, to rebut the presumption of prejudice arising from the jury's use of a dictionary. U.S. Surgical's CACF Brief at 45-47. In addition, U.S. Surgical showed in its opening CAFC brief that words of likely interest to the jury, such as "obviousness" and "presumption" (as used in "presumption of validity"), have markedly different meanings in the patent world than they do in *Webster's New World Dictionary*. *Id.*

In short, the dictionary was non-evidential matter. In affirming the trial court, the CAFC necessarily rejected application of the presumption of prejudice, in direct conflict with the Second Circuit's controlling decision in *United States v. Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985). The CAFC decision also conflicted with the many federal and state court decisions ordering new trials when, as in this case, there was no factual basis for concluding that the jury's use of the dictionary was not prejudicial. This issue is particularly important in patent cases, in which the meaning of words

in a patent often are determinative of the outcome not only of the obviousness analysis, but of infringement as well.

5. Ethicon's Rule 606(b) Argument Is Specious

Relying on Rule 606(b), Fed. R. Evid., Ethicon argues that the trial court would not have been allowed to discover the word or words examined by the jury. Ethicon is wrong. It is *settled* law that Rule 606(b) does *not* forbid a juror from testifying that he or she consulted a dictionary. *See, e.g., United States v. Duncan*, 598 F.2d 839, 866 (4th Cir.) ("juror may testify that she had consulted a dictionary and related her findings to the group" under Rule 606(b)), *cert. denied*, 444 U.S. 871 (1979). Rather, Rule 606(b) prevents inquiry only into the effect that the use of extraneous material had on the jury's deliberations. 598 F.2d at 866. In dictionary cases, courts routinely find out, typically by consulting the jurors, what word or words were looked up, but do not inquire into how the definitions affected their deliberations. The court decides whether a new trial is required by comparing the word or words as defined by the dictionary with the jury charge.

6. The CAFC Improperly Invoked Circuit Rule 36 To Decide This Case

> The most important and most typical indication of the rationality of the judicial function is the reasoned opinion.[14]

The trial court in this case made clearcut errors of law that precluded the CAFC from invoking Circuit Rule 36. P.A. 46a (Rule 36(e)). As was clear under *Read* and now *Markman*, the trial court erred in not deciding the scope and meaning of the claims as a matter of law prior to submitting the case to the jury. The trial court also clearly erred in submitting the dictionary to the jury over both parties' objections. The trial court again erred by not construing the claims after trial, on U.S. Surgical's

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[14] Piero Calamandrei, *The Crisis in the Reasoned Opinion, in* THE LAW AS LITERATURE 683, 683 (Ephraim London ed., 1966).

JMOL motion. If the CAFC regarded these trial errors as nonprejudicial, it had an obligation to inform U.S. Surgical, which brought these errors of law to the CAFC's attention, of its reasoning regarding them as not prejudicial.[15] The appellant's statutory right to judicial review, as much as the need for regularity in the appellate process, required the CAFC to issue a written opinion in these circumstances.

This case seems to be a prime example of the CAFC improperly using Circuit Rule 36 to avoid its obligation of appellate review. The petition for *certiorari* pending in *Pirkle v. Ogontz Controls Co.*, No. 95-45, at 17-23 (U.S. filed July 10, 1995), further documents the CAFC's misuse of Rule 36, and shows that it is not an isolated practice. The CAFC's Rule 36 practice is worthy of this Court's consideration, given that the effect is to deprive appellants of their statutory right of judicial review. This Court's review of this issue would provide much needed guidance to the CAFC, and benefit other courts of appeal as well.

7. The Public Importance Of This Case

Ethicon does not challenge the exceptional public importance of resolving the respective roles of the court and jury in ascertaining the scope and meaning of patent claims in jury trials, a question that arises repeatedly. When, as in this case, a trial court fails to perform this essential role and allows numerous disputes over claim scope and meaning to go to the jury, there is no escape from the need for a new trial because the process by which the jury reached its decision is unknown and unworkable, and therefore unreviewable for error of law.

CONCLUSION

The petition for a writ of certiorari should be granted.

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[15] Circuit Rule 36 also permits summary affirmance only when an opinion "would have no precedential value." P.A. 46a. A written opinion on the dictionary issue would have conflicted with every state and federal court that had considered the issue.

Respectfully submitted,

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APPENDICES

APPENDIX A

DISTRICT COURT'S INSTRUCTIONS CONCERNING CLAIM INTERPRETATION (Feb. 10, 1994)

Let me introduce you to the issues in this case. In this case U.S. Surgical is the owner of United States letter patents number 5,084,057 and number 5,100,420, both entitled apparatus and method for applying surgical clips in laparoscopic and endoscopic procedures. I will refer to these as the '057 and the '420 patents. U.S. Surgicial asserts that Ethicon has infringed claims 1, 2 and 7 of the '057 patent and claim 1 of the '420 patent, by making, using and selling endoscopic multiple clip appliers known as the LIGACLIP ERCA and the LIGACLIP EMCA.

Now, in response Ethicon denies that its devices infringe upon the claims of U.S. Surgical's patents. Ethicon also affirmatively asserts that the U.S. patent surgical patents are invalid because the inventions claimed in the patents were obvious.

What now follows is an explanation of the method you should use and the factors you should consider in order to reach your verdict on the various issues in this case. It is important that you follow the instructions in their entirety and that you proceed with the analysis in the exact order that I've set it out for you. Before you make any decisions, you should read these instructions, and as I've said, you'll have them with you in the jury room, and be certain that you understand them.

Now, for each of claims 1, 2 and 7 of the '057 patent and claim 1 of the '420 patent you should do the following:

First you must construe each one of the patent claims at issue and then you should answer this question: Has U.S. Surgical met its burden of proving by a preponderance of the evidence that the EMCA and ERCA sold

by Ethicon infringe either claims 1, 2 or 7 of the '057 patent or claim 1 of the '420 patent?

Second, you should answer the following question for each claim at issue in the case: Has Ethicon met its burden of proving by clear and convincing evidence that the claims are invalid?

Let's talk a little about patent infringement. In order to succeed on its claim for patent infringement, U.S. Surgical must prove, again by a preponderance of the evidence, that the Ethicon devices infringe upon the claims.

The determination of infringement is a two step process. First, you must determine the meaning of the language of the claims. Second, you must compare the Ethicon device to the language of the claims, as you've interpreted them, in order to determine whether the Ethicon device contains each element of the patent claims. Patent claims can be infringed either literally, which means that the accused device includes each element of the patent claims, or under the Doctrine of Equivalents.

Now, the interpretation, let's talk about the interpretation of claims. The patent claims are the numbered paragraphs at the end of the patent. The claims involved here are claims 1 of the '420 patent and claims 1, 2 and 7 of the '057 patent, and you have each been furnished a copy of these patents and we will see to it that you obviously have copies of these patents with you. The claims describe the words the parameters of the invention. Each claim has various subparts or claim elements. In order to infringe a claim, each element of the claim must be infringed. If any one claim of a patent is infringed, then the patent may be said to be infringed.

Because I have determined that there's a factual dispute here concerning the meaning of the patent claims, you must determine how the claims in this patent should

be interpreted. You should interpret the language of the claim as one of ordinary skill in the art would do.

In interpreting the language of the claims you should consider:

One, the ordinary meaning of the language used in the claim;

Two, the specifications in the patent;

Three, the prosecution history of the patent;

Four, the other claims in the patent;

Five, the prior art in the field.

Now, in this case you have heard expert testimony concerning how those skilled in the art would interpret the claims. You may also rely on this expert testimony in determining the meaning of the patent claims.

As you have learned, there are two types of claim elements in U.S. Surgical's patents: Structure elements and means plus function elements. Whether a claim element is a structure element or a means plus function element will affect how you interpret that particular claim element.

A stucture element identifies a specific structure. In interpreting a structure element, you need only determine what structure is defined by the language of the claim.

A means plus function element describes a means for performing a certain function. When means plus function claims are used, the patent does not protect every structure or component that can be used to perform that function. Rather, means plus function claims must be interpreted to include only the structures described in the patent specifications for perfoming the given function or their equivalent. Therefore, to interpret a means plus function element, you must determine what structure or structures are described in the patent specifications for performing each such function and what structures would constitute their equivalent.

After you have determined the meaning of the claims at issue, you can move on to the next step, comparing the accused devices to the claims as you have interpreted them.

APPENDIX B

U.S. SURGICAL'S PROPOSED INSTRUCTIONS CONCERNING THE CLAIMS AT ISSUE AND THEIR MEANING
(District Court, Feb. 2, 1994)

B. *Meaning of U.S. Surgical's Claims*

1. *Claim 1 of the '420 Patent (PPI 37)*

Claim 1 of the '420 Patent reads in full: In combination:

a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity;

b) an endoscopic clip applier having:

i) a frame;

ii) an endoscopic portion, defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith, said endoscopic portion further including a plurality of surgical clips disposed in any array and clip closing means for sequentially closing said surgical clips; and

iii) seal means associated and adapted to cooperate with at least one of said endoscopic portion and said frame to obstruct passage of gaseous media from the body cavity.

This claim covers the combination of "a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity." Claim element a) calls for a trocar having a cannula with valve means for sealing the cannula. The claim element "valve means for sealing said cannula" is a means-plus-function claim element. The stated function, as I interpret it, is to seal the cannula. The struc-

ture for performing this function includes all such structures contained in trocars known in the art at the time the '420 Patent Application was filed. Such trocars contain structures both to seal the cannula when no instrument is in the cannula, such as a flapper-type valve, and structures which form a seal between the instrument and the cannula when an instrument is inserted in the cannula, such as a gasket. The flapper valve may engage the gasket, as in the U.S. Surgical Surgiport Trocar, or be separate from the gasket, as in reusable instruments that were known at the time the '420 Patent Application was filed. Therefore, if you find that the Ethicon Endopath Trocar is a trocar having the same or equivalent structure to the structures I have just described, then the accused devices satisfy claim element a) of Claim 1 of the '420 Patent.

The next claim element is claim element "b) an endoscopic clip applier" having the further elements identified in parts b)i), b)ii), and b)iii). I interpret the word "endoscopic" in the phrase "endoscopic clip applier" to refer generally to instruments having elongated and relatively narrow operating portions for insertion into a cannula or a small wound in the skin.

The next claim element—b) i)—calls for "a frame." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices include a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The initial clause of the next claim element—b) ii)—recites "an endoscopic portion defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through

said valve means in sealing engagement therewith." I interpret this structure claim element to mean an endoscopic portion extending away from the frame which can be inserted through the trocar cannula so that the cannula valve means forms a seal around the endoscopic portion. Therefore, if you find that the defendants' accused devices contain an endoscopic portion extending away from the frame which can be inserted through a trocar cannula so that the cannula valve means forms a seal around the endoscopic portion, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The next clause of claim element b) ii) recites "said endoscopic portion further including a plurality of surgical clips disposed in an array." I interpret this structure claim element to mean that more than one clip is stored in the endoscopic section of the claimed instrument. For purposes of this claim, it is immaterial how the clips are stored. Therefore, if you find that numerous clips are stored in the endoscopic portion of defendants' accused devices, regardless of how they are stored, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The final clause of claim element b) ii) calls for "clip closing means for sequentially closing said surgical clips." This is a means-plus-function claim element. The stated function of this particular means-plus-function claim element is "sequentially closing said surgical clips." I interpret this to mean the closing of surgical clips one at a time and one after another. The structure or "means" described in the patent specification for performing the stated function is a pair of flexible opposing jaws which are cammed together into closure by a distally moving channel.

In order to find that this claim element of the '420 Patent has been met, you must first find that the defendants' accused devices perform the function of closing surgical clips one at a time and one after another. Then you

must find that the defendants' accused devices have a pair of flexible opposing jaws and a distally-moving cam channel, or equivalent structure, which perform this function. One example of equivalent structure, as I explained earlier, is structure which a person of ordinary skill in the art would consider as interchangeable with the structure disclosed in the patent specification for performing the stated function.

The final claim element of Claim 1 of the '420 Patent reads as follows: "seal means associated and adapted to cooperate with at least one said endoscopic portion and said frame to obstruct passage of gaseous media from the body cavity." This claim element is also stated in means-plus-function language. The stated function, as I interpret it, is to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. It is not the stated function to prevent all gas from escaping. The structure or "means" described in the patent specification for performing this function is close tolerances for the internal moving parts of the endoscopic portion, and/or a seal block with or without silicone grease.

In order to find that this claim element of the '420 Patent has been met, you must first find that the defendants' accused devices perform the function of obstructing the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Then you must find that the defendants' accused devices utilize close tolerances for the internal moving parts of the endoscopic portion, and/or a seal block with or without silicone grease, or equivalent structure, which perform this function.

If you find that defendants' Endopath trocar and EMCA/ERCA devices meet all of the limitations recited in the claims, and that defendants have made, used or sold

a combination of such a trocar and EMCA/ERCA, then Claim 1 is infringed.

2. *Claim 1 of the '057 Patent (PPI 38)*

Claim 1 of the '057 Patent reads in full:

An apparatus for endoscopic application of surgical clips to body tissue which comprises:

a) frame means;

b) endoscopic means connected to said frame means of generally elongated configuration and extending distally from said frame means and including:

i) means for storing a plurality of surgical clips;

ii) means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped;

iii) means for at least partially closing each said clip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means; and

iv) gaseous sealing means.

Claim 1 uses the preamble and transitional phrase "An apparatus for endoscopic application of surgical clips to

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'420 Patent, Col. 15, lines 36-48 (claim element 1a)); '420 Patent, Col. 1, lines 47-51 (claim elements 1a) & 1b)—combination of endoscopic clip applier and trocar); '420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68, Figure 2 (claim element 1b)i)—frame); Col. 3, line 29 and 54, Col. 4, line 13 (claim element 1b)ii)—endoscopic portion insertable into cannula); Col. 4, lines 23-25, Col. 8, line 66 (claim element 1b)ii)—clip closing means for sequentially closing said surgical clips); Col. 4, line 64—Col. 5, line 1, Col. 5, lines 4-17 (claim element b)iii—seal means); Trial Testimony of Basam E. Nabulsi, Esq., pp. 708-716 (discussing meaning to person of ordinary skill in art of corresponding structure for valve means claim element).

body tissue which comprises." I interpret the words "an apparatus for endoscopic application of surgical clips to body tissue" to mean an endoscopic multiple clip applier. Therefore, if you find that defendants' accused devices are endoscopic multiple clip appliers, then the preamble of Claim 1 of the '057 Patent has been met. As I explained earlier, the word "comprises" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended. The presence of additional components in the accused product is irrelevant to whether the product infringes the patent claim. Therefore, if you find that defendants' accused devices contain all of the elements in Claim 1 and, in addition, defendants' accused devices contain additional components, defendants' accused devices still infringe the claim.

Claim element 1a) reads "frame means." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices have a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

The initial clause of the next claim element—1b)—reads "endoscopic means connected to said frame means of generally elongated configuration and extending distally from said frame means." I interpret this structure claim element to mean an endoscopic portion connected to the frame and extending away from the frame. Therefore, if you find that the defendants' accused devices have an endoscopic portion connected to the frame and extending away from the frame, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

Claim elements 1b)i), 1b)ii), 1b) iii), and 1b)iv) are further elements which are part of and included in the endoscopic portion.

Clause i) of claim element 1b) reads "means for storing a plurality of surgical clips." This is a means-plus-function claim element. The stated function, as I interpret it, is to store a plurality of surgical clips. The structure or means disclosed in the patent specification for performing this function is a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument.

In order to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of storing a plurality of surgical clips. Then you must find that the defendants' accused devices have a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument, or equivalent structure, which perform this function.

Clause ii) of claim element 1b) reads "means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped." This is a means-plus-function claim element. The stated function, as I interpret it, is to advance clips one at a time to the jaws. The structure or means described in the patent specification for performing this function is a pusher bar and escapement tabs extending into the path of the clips.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of advancing clips one at a time to the jaws. Then you must find that the defendants' accused devices have a pusher bar and escapement tabs extending into the path of the clips, or equivalent structure, which perform this function.

Clause iii) of claim element 1b) reads "means for at least partially closing each said clip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means." This is a means-plus-function claim element. The stated function, as I interpret it, is to at least partially close surgical clips sufficiently to grip body tissue. The structure or means described in the patent specification for performing this function is flexible opposing jaws and a distally moving cam channel.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of at least partially closing surgical clips sufficiently to grip body tissue. Then you must find that the defendants' accused devices have flexible opposing jaws and a distally moving cam channel, or equivalent structure, which performs this function.

The final clause iv) of claim element 1b) reads "gaseous sealing means." I interpret this as a structure claim element which requires a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Therefore, if you find that defendants' accused devices contain a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

'057 Patent, Abstract, 420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68 (claim element 1a)—frame means); 057 Patent, Col. 5, lines 11-13 (claim element 1b)—endoscopic portion); '057 Patent, Col. 3, lines 37-41 (claim element 1b)i)—clip storing means); 057 Patent, Col. 3, lines 42-51, '420 Patent, Col. 14, lines 9-12 (claim element 1b)ii)—clip advancing means; '420 Patent, Col. 4, lines 23-25 (claim element 1b)iii)—clip closing means); '420 Patent, Col. 4, line 64 through Col. 5, line 1, Col. 5, lines 4-17 (claim element 1b)iv) —gaseous sealing means).

3. *Claim 2 of the '057 Patent (PPI 39)*

Claim 2 of the '057 Patent reads in full: "The apparatus according to Claim 1 wherein said gaseous seal means comprises silicone grease." Claim 2 of the '057 Patent is a dependent claim. As I explained earlier, a dependent claim includes a reference to at least one other claim in the patent. In this case, Claim 2 of the '057 Patent makes reference to Claim 1 of the '057 Patent by the phrase "the apparatus according to claim 1." As a dependent claim, Claim 2 incorporates all of the limitations contained in Claim 1 which I have just interpreted for you. Claim 2 also includes an additional element. All the elements of Claims 1 and 2 must be present before infringement of Claim 2 can be found.

The additional element of Claim 2 reads "said gaseous seal means comprises silicone grease." I interpret this as a structure claim which requires the use of silicone grease as part of the seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed.

In order to find that Claim 2 of the '057 Patent has been infringed by defendants' accused devices, you must first find that defendants' accused devices contain all of the claim elements of Claim 1 of the '057 Patent as I have interpreted them. Then you must find that defendants' accused devices also contain silicone grease as part of the seal.

4. *Claim 7 of the '057 Patent (PPI 40)*

Claim 7 of the '057 Patent reads in full:

A disposable apparatus for endoscopic application of surgical clips to body tissue which comprises:

a) a frame;

b) an elongated endoscopic section connected at the proximal end thereof to said frame and extending distally from said frame, said endoscopic section including:

i) means for storing a plurality of surgical clips;

ii) a pair of jaws positioned at the distal portion of said endoscopic section and adapted for reception of said clips;

iii) means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped;

iv) means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue; and

v) gaseous sealing means.

Claim 7 uses the preamble and transitional phrase "A disposable apparatus for endoscopic application of surgical clips to body tissue which comprises." I interpret the words "a disposable apparatus for endoscopic application of surgical clips to body tissue" to mean a disposable endoscopic multiple clip applier. Therefore, if you find that defendants' accused devices are disposable endoscopic multiple clip appliers, then the preamble of claim 7 of the '057 Patent has been met. As I explained earlier, the word "comprises" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended. The presence of additional components in the accused product is irrelevant to whether the product infringes the patent claim. Therefore, if you find that defendants' accused devices contain all of the elements in Claim 7 and, in addition, defendants' accused devices contain additional components, defendants' accused devices still infringe the claim.

Claim element 7a) reads "a frame." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices have a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

The initial portion of the next claim element—7b)—reads "an elongated endoscopic section connected at the proximal end thereof to said frame and extending distally from said frame." I interpret this structure claim element to mean an endoscopic section connected to the frame at its proximal end and extending away from the frame. Therefore, if you find that the defendants' accused devices have an endoscopic section connected to the frame at its proximal end and extending away from the frame, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

Claim elements 7b)i), 7b)ii), 7b)iii), 7b)iv), and 7b)v) are further elements which are part of and included in the endoscopic portion.

Clause i) of claim element 7b) reads "means for storing a plurality of surgical clips." This is a means-plus-function claim element. The stated function, as I interpret it, is to store a plurality of surgical clips. The structure or means disclosed in the patent specification for performing this function is a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument.

In order to find that this claim element of the '057 Patent has been met, you must find that the defendants' accused devices perform the function of storing a plurality of surgical clips. Then you must find that the defendants'

accused devices have a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument, or equivalent structure, which perform this function.

Clause ii) of claim element 7b) reads "a pair of jaws positioned at the distal portion of said endoscopic section and adapted for reception of said clips." I interpret this structure claim element to mean a pair of jaws adapted to receive surgical clips. Therefore, if you find that defendants' accused devices have a pair of jaws adapted to receive surgical clips, then the defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

Clause iii) of claim 7b) reads "means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped." This is a means-plus-function claim element. The stated function, as I interpret it, is to advance clips one at a time to the jaws. The structure or means described in the patent specification for performing this function is a pusher bar and escapement tabs extending into the path of the clips.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of advancing clips one at a time to the jaws. Then you must find that the defendants' accused devices have a pusher bar and escapement tabs extending into the path of the clips, or equivalent structure, which perform this function.

Clause iv) of claim element 7b) reads "means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue." This is a means-plus-function claim element. The stated function, as I interpret it, is to at least partially close the jaws to at least partially close the surgical clips about the body tissue. The structure or means described in the patent specification for performing this function is a dis-

tally-moving cam channel capable of at least partially closing the jaws.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of at least partially closing the jaws to at least partially close the surgical clips about the body tissue. Then you must find that the defendants' accused devices have a distally-moving cam channel capable of at least partially closing the jaws, or equivalent structure, which performs this function.

The final clause v) of claim element 7b) reads "gaseous sealing means." I interpret this as a structure claim element which requires a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Therefore, if you find that defendants' accused devices have a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

5. *Inventor As Lexicographer (PPI 41)*

Because it is often difficult to describe a novel invention in words, the patent law allows an inventor to be his or her own lexicographer. This means that an inventor has a verbal license to define the terms that appear in the patent claims. If the inventor defines a word used in a patent claim in the specification, that definition is controlling.

'057 Patent, Abstract, '420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68 (claim element 7a)—frame); '057 Patent, Col. 5, lines 11-13 (claim element 7b)—endoscopic portion); '057 Patent, Col. 3, lines 37-41 (claim element 7b)i)—clip storing means); '057 Patent, Col. 3, lines 42-51 (claim element 7b)iii)—clip advancing means); '057 Patent, Col. 8, lines 6-8, '420 Patent, Col. 8, lines 45-46 (claim element 7b)iv)—clip closing means); '420 Patent, Col. 5, lines 4-17 (claim element 7b)v)—gaseous sealing means).

In light of this patent law principle, I have instructed you on the meaning of each structure claim element in the '420 and '057 Patents. For the structure claim elements, you must decide whether the accused devices have these structures as I have defined them.

For each means-plus-function claim element, I have instructed you on the corresponding structure in the '420 and '057 specifications for performing the stated function. For the means-plus-function claim elements, it is your job to decide whether the corresponding structure for performing the stated function, as I have defined it, or its equivalent exists in the accused devices. If other structure exists in defendants' accused devices which assists in performing the stated function of a particular claim element, that is not relevant to the question of infringement because it is not part of the claim element as defined by the inventor.

In addition, if the structure in the accused devices for performing the stated function of a claim element also performs an additional function, that is not relevant to the question of infringement because the additional function is not part of the claim element as defined by the inventor.

6. *Infringer Cannot Avoid Infringement By Making Modifications If All Claim Elements Are Met (PPI 42)*

As I explained earlier, when you are deciding whether defendants accused devices satisfy the means-plus-function

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McGill Inc. v. John Zink Co., 736 F.2d 666, 674 (Fed. Cir.), ("Words which were defined in the specification must be given the same meaning when used in a claim"), *cert. denied*, 469 U.S. 1037 (1984); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988); *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993); *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1481-82 (Fed. Cir.), *cert. denied*, 469 U.S. 924 (1984).

claim elements of plaintiff U.S. Surgical's patent claims at issue, you must first decide whether defendants' accused devices perform the stated function of a means-plus-function claim element. Then you must decide whether the accused devices perform that function by structure that is the same as or equivalent to the corresponding structure disclosed in the patent specification. The structure in the accused devices need not be identical to the structure disclosed in the patent specification for performing the stated function in order to satisfy the claim element. The only issue for you to decide with respect to these claim elements is whether defendants' accused devices have the required structure for performing the stated function.

7. *"Clip Closing Means" (PPI 43)*

Defendants have presented expert testimony that their accused devices do not satisfy the limitation in means-plus-function claim element 1 b)ii) of the '420 Patent calling for "clip closing means for sequentially closing said surgical clips." Defendants' expert offered a number of reasons why the structure in the accused devices for performing the function of closing surgical clips one after another and one at a time is not the same or equivalent. Defendants' expert said that the accused devices contain differently configured jaws than the U.S. Surgical jaws. The configuration of the jaws, however, bears no relevance to your determination of whether this claim element has been satisfied. The specific structure of the jaws is not part of the claim element because the claim element does not include how the jaws abut when cammed together, the width of the jaws, or how the forces of the jaws are applied to clips. The structure described in the patent specification for performing the

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Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042 (Fed. Cir. 1993); *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1575 (Fed. Cir. 1985).

function of closing surgical clips one at a time and one after another is simply flexible opposing jaws and a distally-moving cam channel.

In addition, defendants' expert testified that the activivating handle and other structure attached to the frame perform the function of sequentially closing surgical clips. You may not consider structure such as the activating handle because that structure is not within the shaft or endoscopic portion and because it is not part of the clip closing means. The clip closing means claim limitation refers only to structure within the endoscopic portion. Therefore, you must look only to the structure within the endoscopic portion of defendants' accused devices for performing the function of closing surgical clips one after another and one at a time to determine whether it is the same or equivalent to the structure described in the patent specification.

As I explained earlier, the patent law allows an inventor to be his or her own lexicographer. An inventor can define the relevant structure for performing a stated function in any way he or she wants. While other structure may in fact assist in performing the stated function of a means-plus-function claim, you must consider only the structure specified by the inventor for performing the function of a particular claim element. Therefore, while the activating handle of defendants' accused devices must be squeezed to cam the jaws shut, the activating handle is not part of the structure that performs the function of closing surgical clips one after another and one at a time. The claim element is limited to structure in the endoscopic portion and is specifically defined as flexible opposing jaws which are cammed together into closure by a distally moving cam channel.

ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1580 (Fed. Cir. 1988).

8. *"Seal Means" (PPI 44)*

With respect to the means-plus-function claim element in Claim 1 of the '420 Patent reciting "seal means . . . to obstruct passage of gaseous media from the body cavity," defendants have offered expert testimony that the structure in defendants' accused devices for obstructing the passage of gas from the body cavity is not the same as or equivalent to the structure described in the specifications of U.S. Surgical's patents. Defendants' expert testified that the accused devices have a central chamber and a series of additional chambers which serve other functions apart from sealing. Defendants' expert testified that the additional chambers serve as overflow for any grease that migrates from the central chamber as the feed bar and cam channel in defendants' accused devices move back and forth. He also testified that the chambers function to store body fluid that may come into the accused devices during a surgical procedure.

The additional structure identified by defendants' expert, such as a multi-chamber system to prevent the migration of silicone grease, does not mean that defendants' accused devices do not have sealing means as recited in the claims. It is irrelevant to the question of infringement that the additional structure in the accused devices performs added functions, such as reducing pressure or capturing grease or body fluids, or assisting or improving in sealing. The only question you must answer for this claim element is whether defendants' accused devices include structure that provide close tolerances with the internal moving parts of the endoscopic portion, such as a seal block with silicone grease, or equivalent structure, which perform the function of obstructing the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed.

ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1580 (Fed. Cir. 1988); *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1580-81 (Fed. Cir. 1984).

9. *"Clip Advancing Means" (PPI 45)*

Defendants' expert has testified that the pusher bar in the accused devices for performing the function expressed as advancing or individually advancing the clips from clip storage to the jaws is not the same as or equivalent to the structure described in U.S. Surgical's patent specifications.

Defendants' expert pointed out that the pusher bar in the accused devices is wider than the pusher bar disclosed in the U.S. Surgical patent drawings and pushes the clips at a point further from the center axis of the clip. These differences are irrelevant to the question of infringement because these structural details are neither set forth in nor required by the claim elements themselves. The claim elements merely require a pusher bar. The dimensions of the pusher bar are irrelevant so long as the pusher bar in defendants' accused devices functions to advance or individually advance the clips from clip storage to the jaws.

The other difference highlighted during the testimony of defendants' expert is that the pusher bar depicted in U.S. Surgical's patent is in two planes while the Ethicon pusher bar is in one plane. This difference is irrelevant to these claim elements because the claim elements merely require that the pusher bar individually advance the clips from clip storage to the jaws. If you find that defendants' accused devices have a pusher bar which performs the function of individually advancing the clips from clip storage into the jaws, then the claim elements are satisfied.

10. *Automatic v. Semi-Automatic (PPI 46)*

U.S. Surgical's patent claims at issue in this case do not address whether the clip is advanced immediately or automatically upon release of the activating handle, as in the defendants' accused devices, or whether they are advanced after releasing a safety mechanism, or semi-

automatically, as in the U.S. Surgical device. As I mentioned earlier, a patent claim need not include every element or every structure in a claimed device. Since the question of the automatic versus the semi-automatic feature is not part of the claims at issue here, this difference is not relevant to your analysis of whether defendants' accused devices infringe U.S. Surgical's patents either literally or under the doctrine of equivalents. I will discuss the two types of infringement in a moment.

11. *Relevant Structure in Endoscopic Portion (PPI 47)*

When you are comparing defendants' accused devices to U.S. Surgical's patent claims, you will be mainly focused on analyzing structure within the endoscopic portion of defendants' accused devices. This is because the vast majority of structure claim elements and means-plus-function claim elements at issue all pertain to the endoscopic portion. For example, in Claim 1 of the '057 Patent, the only claim element which requires you to look at the non-endoscopic portion of defendants' accused devices is claim element 1a) calling out "frame means." All of the remaining claim elements are sub-elements of claim element b) which relates only to the endoscopic means. Therefore, the relevant structure in the accused devices for determining infringement of the claim elements for clip storing means, clip advancing means, clip closing means, and gaseous sealing means in my example of Claim 1 of the '057 Patent must be located in the endoscopic portion of the accused devices.

The only claim elements which require you to consider structure in defendants' accused devices in the non-endoscopic portion are the claim elements in all of the

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'057 Patent, Claim 13, Col. 18, lines 15-18; *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 699 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984); *Black & Decker, Inc., v. Hoover Service Ctr.*, 765 F. Supp. 1129 (D. Conn. 1991).

claims relating to the frame of the claimed invention. One exception is the claim element for seal means in Claim 1 of the '420 Patent, as the seal means in this claim is not limited to the endoscopic portion but could be found within the non-endoscopic portion of the instrument. The only other exception is the claim element of Claim 1 of the '420 Patent directed to a trocar for receiving the endoscopic multiple clip applier.

7. *Cumulative Open Multiple Clip Applier Art (PPI 61a)*

You should understand that in this case, you do not need to decide whether the patent examiner had before him all relevant prior art concerning non-endoscopic "open" multiple clip appliers. The patent examiner had before him sufficient open multiple clip applier art. In particular, the examiner had in the record before him the Montgomery '373 patent, the Premium Surgiclip brochure, and various other prior art references that you have heard evidence about. For the examiner's purposes the additional open multiple clip applier art that was not before him, including the patent covering the Premium Surgiclip device (Green '226), was merely cumulative of the prior art considered by the examiner and, therefore, not material to his decision. Accordingly, the fact that the examiner considered the Premium Surgiclip brochure and not the Green '226 Patent, and that there existed in the prior art other open multiple clip appliers that were not considered by the examiner has no effect on the presumption that U.S. Surgical's patents are nonobvious and does not make the presumption easier to overcome.

Although such cumulative open multiple clip applier prior art has no effect on the presumption of validity, should you find it relevant, you should consider such art when evaluating the obviousness question.

Recommended Ruling On Plaintiff's Motion For Summary Judgment On The Issue Of Alleged Inequitable Conduct, pp. 16-19, 21-22

9. *Prior Art References That Teach Away (PPI 72)*

You may find that there are disclosures in the prior art relied on by defendants that teach the opposite idea, or away from, the inventions claimed in U.S. Surgical's patents. Where a prior art reference teaches away from the claimed invention, you should consider this as evidence that the claimed invention is nonobvious over the prior art.

20. *Absence of Secondary Considerations is a Neutral Factor (PPI 83)*

While the presence of secondary considerations may be strong evidence supporting nonobviousness, the absence of secondary considerations is in no way suggestive of obviousness of invalidity. Thus, you should not consider evidence presented by defendants to show the absence of secondary considerations as evidence of obviousness. If you credit this evidence at all, you should consider it only for whatever bearing it may have on whether U.S. Surgical established the existence of secondary considerations in support of nonobviousness.

21. *What is Not Evidence of Obviousness (PPI 84)*

The patent statutes specifically provide that "patentability shall not be negatived by the manner in which the invention was made." What this means is that evidence of how an invention was made, or how long or short

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(February 11, 1993) (holding that open multiple clip applier art beyond the Premium Surgiclip brochure, Montgomery '373, and McGarry '254 was cumulative).

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 301 (Fed. Cir. 1985).

Medtronic, Inc. v. Intermedics, Inc., 799 F.2d 734, 739 & n. 13 (Fed Cir. 1986), *cert. denied*, 479 U.S. 1033 (1987); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 960 (Fed. Cir. 1986).

a time it took to make it, is immaterial to whether the invention is obvious.

Likewise, how obvious U.S. Surgical's invention may have seemed to U.S. Surgical's own inventors should not be considered by you in determining whether the invention was obvious. As I have stated, the test for obviousness is whether the invention would have been obvious to a *hypothetical* person of ordinary skill—not whether it would have been obvious to the actual inventors who conceived of and developed the patented invention. The law does not allow the inventors' own work to be used against them.

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35 U.S.C. § 103; *Shiley Inc. v. Bentley Laboratories, Inc.*, 794 F.2d 1561, 1568 (Fed. Cir. 1986); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 874 (Fed. Cir. 1985); *Standard Oil v. American Cyanamid*, 774 F.2d 448, 454 (Fed. Cir. 1985); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986), *cert. denied* 484 U.S. 823 (1987).

APPENDIX C

EXCERPTS CLOSING ARGUMENTS
(District Court, Feb. 10, 1994)

In closing, Ethicon's trial counsel (Mr. Diskant) argued as follows:

> I also told you at the outset that if these patents were construed to be as broad as U.S. Surgical says they are, to cover any endoscopic multiple clip applier that has a frame and a shaft and jaws and clips and a seal, well, then it would be obvious and invalid, and I think we've proved that, too. A. 666 (Tr. 2669).
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> * * * *
>
> If you construe the patent this way, we don't infringe. We don't have those structures, we don't have the equivalents to those structures. The other way you can look at it is their way. Doesn't matter what the structures are. *Any* jaws, *any* pusher bar, *any* feed system, *any* escapement, that's what they say is described in their patents, and then, of course, because it's a means plus function claim, they also get the equivalents. *Any jaws plus equivalents, any pusher bar plus equivalents, any feed system plus equivalents. That's everything.* There's nothing left, if that's the way you construe a patent. But if that's what the patent is, it doesn't matter what they invented. It's really just an obvious conception. It's an invalid patent.
>
> So respectfully we submit we win either way you analyze it. You look at it narrowly as we suggest what we think is right, they've got a valid patent, but we don't infringe. *You look at it their way, their patent is hopeless.* A. 673 (Tr. 2709) (italics added).

In closing, U.S. Surgical's trial counsel (Mr. McDaniels) responded as follows:

> U.S. Surgical's invention is not a patent on any endoscopic multiple clip applier. It is a patent on an endoscopic multiple clip applier that has in its endoscopic section *the particular means* for clip storage, both clip advancing, and clip closing that is *set forth in the patent and in the definitions of the patent*. That is what is protected. A. 673 (Tr. 2710-11) (italics and underlining added).